

# Chapter 1100 — Intent-to-Use Applications and Related Documents

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## **1101 BONA FIDE INTENTION TO USE THE MARK IN COMMERCE**

## **1102 INITIAL EXAMINATION OF INTENT-TO-USE APPLICATIONS**

1102.01 Substantive Refusals

1102.02 Drawings

1102.03 Intent-to-Use Applications and the Supplemental Register [R-1]

1102.04 Claims of Acquired Distinctiveness under §2(f)

## **1103 ALLEGATIONS OF USE**

## **1104 AMENDMENT TO ALLEGE USE UNDER §1(c) OF THE ACT**

1104.01 Minimum Requirements for Filing an Amendment to Allege Use

1104.01(a) Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements

1104.01(b) Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements

1104.01(c) Processing Defective Amendment to Allege Use Filed With Other Amendments

1104.02 Form of Amendment to Allege Use

1104.03 Time for Filing Amendment to Allege Use

1104.03(a) Use on All Goods Required Before Filing

1104.03(b) The “Blackout Period”

1104.03(c) Processing Amendments to Allege Use Filed During the Blackout Period

1104.04 Processing Timely Amendments to Allege Use Located After Publication

1104.05 Amendments to Allege Use Filed in Conjunction With Application

1104.06 Processing Amendments to Allege Use Received Before Application is Assigned to an Examining Attorney

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1104.07 Amendments to Allege Use and *Ex Parte* Appeals
- 1104.08 Necessary Elements in a Complete Amendment to Allege Use
- 1104.09 Examination of Amendment to Allege Use by Examining Attorney
  - 1104.09(a) Ownership
  - 1104.09(b) Verification and Date of Execution
  - 1104.09(c) Identification of Goods or Services
  - 1104.09(d) Use in Commerce and Dates of Use
  - 1104.09(e) Specimen [R-1]
  - 1104.09(f) Drawing
  - 1104.09(g) Fees
  - 1104.09(h) Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use
- 1104.10 Amendment and Withdrawal of Amendment to Allege Use
- 1104.11 Approval of Amendment to Allege Use After Examination [R-2]

### **1105 PUBLICATION OF INTENT-TO-USE APPLICATIONS FOR OPPOSITION**

### **1106 NOTICE OF ALLOWANCE**

- 1106.01 Issuance of the Notice of Allowance
- 1106.02 Action by Examining Attorney After Issuance of the Notice of Allowance
- 1106.03 Cancellation of Notice of Allowance
- 1106.04 Correction of Errors in Notice of Allowance

### **1107 AMENDMENT AFTER ISSUANCE OF THE NOTICE OF ALLOWANCE AND BEFORE FILING OF THE STATEMENT OF USE [R-2]**

- 1107.01 Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed [R-2]

### **1108 REQUESTS FOR EXTENSIONS OF TIME TO FILE THE STATEMENT OF USE**

- 1108.01 Time for Filing Requests for Extensions of Time to File the Statement of Use [R-1]
- 1108.02 Requirements for Request For An Extension of Time to File a Statement of Use

## **INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS**

- 1108.02(a) Ownership
- 1108.02(b) Verification
- 1108.02(c) Filing Fee
- 1108.02(d) Identification of Goods or Services
- 1108.02(e) Bona Fide Intention to Use the Mark in Commerce
- 1108.02(f) Good Cause Required for Extensions Beyond the First Six-Month Extension
- 1108.03 Only One Extension Request May Be Filed With or After a Statement of Use
  - 1108.03(a) Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney
- 1108.04 Recourse After Denial of Extension Request
- 1108.05 Petitions From Denial of Request For An Extension of Time to File Statement of Use

## **1109 STATEMENT OF USE UNDER §1(d) OF THE TRADEMARK ACT**

- 1109.01 Minimum Filing Requirements for a Statement of Use
- 1109.02 Review for Compliance with Minimum Filing Requirements
  - 1109.02(a) Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements of 37 C.F.R. §2.88(e)
- 1109.03 Use on All Goods or Services Required Before Filing
- 1109.04 Time for Filing Statement of Use [R-1]
- 1109.05 Form of Statement of Use
  - 1109.05(a) Papers Prepared for Filing as an Amendment to Allege Use May Be Filed as a Statement of Use
- 1109.06 Necessary Elements in a Complete Statement of Use
- 1109.07 Examination of the Statement of Use — In General
- 1109.08 The “Clear-Error” Standard in Examination of the Statement of Use
- 1109.09 Use in Commerce
  - 1109.09(a) Dates of Use
  - 1109.09(b) Specimens
- 1109.10 Ownership
- 1109.11 Verification and Execution

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1109.11(a) Authority of Signatory
- 1109.11(b) Verification of Essential Elements
- 1109.11(c) Date of Execution
- 1109.11(d) Signature of Electronically Transmitted Statement of Use
- 1109.12 Drawing
- 1109.13 Identification of Goods and Services in Statement of Use
- 1109.14 Classification
- 1109.15 Filing Fees
  - 1109.15(a) Processing Deficient Fees
- 1109.16 Correcting Defects in Statement of Use
  - 1109.16(a) Statutory Requirements That Must Be Met Within Statutory Filing Period
  - 1109.16(b) Issuance of Examining Attorney's Office Action Holding that a Statement of Use Does Not Meet the Minimum Filing Requirements
  - 1109.16(c) Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements
  - 1109.16(d) Response to Office Action Required Within Six Months of Mailing Date Regardless of Expiration Date of Period for Filing the Statement of Use
  - 1109.16(e) Applicant's Recourse After Refusal of Registration
- 1109.17 Withdrawal of the Statement of Use Prohibited
- 1109.18 Approval of the Statement of Use

### **1110 REQUEST TO DIVIDE AN APPLICATION**

- 1110.01 Time for Filing Request to Divide
- 1110.02 Fee for Filing Request to Divide
- 1110.03 Processing Request to Divide
- 1110.04 Dividing an Application When Statement of Use is Due
- 1110.05 Dividing an Application When Response to Office Action is Due
- 1110.06 Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board
- 1110.07 Dividing a §44 Application [R-2]

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

1110.08 Division of Registration Not Permitted

### **1101 Bona Fide Intention To Use the Mark In Commerce**

Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce “under circumstances showing the good faith of such person.”

A verified statement of the applicant’s bona fide intention to use the mark in commerce must be included in intent-to-use applications under §1(b), and in applications under §44, 15 U.S.C. §1126. If the verification is not filed with the initial application, the verified statement when filed must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. 37 C.F.R. §§2.34(a)(2)(i), 2.34(a)(3)(i) and 2.34(a)(4)(ii). *See* TMEP §§804 *et seq.* regarding verifications.

A verified statement of the applicant’s continued bona fide intention to use the mark in commerce must be included in a request for an extension of time to file a statement of use. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3); TMEP §§1108.02 and 1108.02(e).

Reasonable variations in the wording of the statement may be acceptable. For example, the applicant may state that it has “a bona fide intention to use in commerce the mark on or in connection with...,” or may use the words “good faith” instead of “bona fide.” However, the wording “in commerce” is required and cannot be varied. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); *In re B.E.L.-Tronics Ltd.*, 24 USPQ2d 1397 (Comm’r Pats. 1991).

*See* TMEP §1201.03(a) regarding an assertion by an intent-to-use applicant of a bona fide intention to use the mark in commerce through a related company.

*See* TMEP §1008 regarding the requirement for an allegation of a bona fide intention to use the mark in commerce in an application filed under §44 of the Trademark Act.

The Office will *not* evaluate the good faith of an applicant in the *ex parte* examination of applications. Generally, the applicant’s sworn statement of a bona fide intention to use the mark in commerce will be sufficient evidence of good faith in the *ex parte* context. Consideration of issues related to good faith may arise in an *inter partes* proceeding, but the Office will not make an inquiry in an *ex parte* proceeding unless evidence of record clearly indicates that the applicant does not have a bona fide intention to use the mark in commerce.

### **1102 Initial Examination of Intent-to-Use Applications**

In an intent-to-use application, the examining attorney will potentially examine the application twice: first, when it is initially filed based on a bona fide intention to use the mark in commerce under 15 U.S.C. §1051(b), and second, when the applicant

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

files an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d). After receipt of the application, the examining attorney will initially examine the application to determine whether the mark is eligible for registration but for lack of use. If the mark is determined to be eligible, the mark will be approved for publication and published for opposition. If the applicant has not submitted an amendment to allege use before approval for publication, and the application is not opposed or survives all oppositions filed, the Office will issue a notice of allowance. 15 U.S.C. §1063(b); 37 C.F.R. §2.81. In such a case, the applicant must submit a statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88. If an amendment to allege use is filed and accepted before approval for publication, the application will be processed in the same manner as a use application from that point forward.

This section only addresses examination before publication. *See* TMEP §§1109 *et seq.* regarding the filing and examination of the statement of use after issuance of the notice of allowance.

The intent-to-use application is subject to the same requirements and examination procedures as other applications, except as specifically noted. The examining attorney must raise all possible issues in initial examination, without regard to whether the applicant will file an amendment to allege use or statement of use.

### **1102.01 Substantive Refusals**

To the fullest extent possible, the examining attorney will examine an intent-to-use application for registrability under Trademark Act §§1, 2(a), 2(b), 2(c), 2(d), and 2(e), 15 U.S.C. §§1051 and 1052(a), (b), (c), (d), and (e), according to the same procedures and standards that apply to any other application. That is, the examining attorney must make all appropriate refusals with respect to issues such as ownership, deceptiveness, mere descriptiveness, geographic significance, and surname significance. *In re Bacardi & Co. Limited*, 48 USPQ2d 1031 (TTAB 1997); *In re American Psychological Association*, 39 USPQ2d 1467 (Comm'r Pats. 1996). The examining attorney cannot issue a requirement or refusal under these sections during examination of the statement of use if the issue could or should have been raised during the initial examination, unless the failure to issue the refusal or requirement would be a clear error. *See* TMEP §1109.08.

The examining attorney should investigate all possible issues regarding registrability through all available sources. If appropriate, the examining attorney may request that the applicant provide literature or explanation concerning the intended manner of use of the mark under 37 C.F.R. §2.61(b). *See In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

While the examining attorney must examine and act on all possible issues in the initial examination of the application, refusals specifically tied to use of the mark (*e.g.*, ornamentation) should generally be addressed after the applicant submits an amendment to allege use or statement of use *and* a specimen. *See* TMEP §§1202 *et*

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

*seq.* regarding use as a mark. In a §1(b) application for which no specimen has been submitted, if the examining attorney believes that a refusal of registration based on the ground that the subject matter does not function as a mark may be made after an allegation of use is submitted, the potential refusal should be brought to the applicant's attention in the first action issued by the Office. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the Office is not precluded from refusing registration on this basis.

### **1102.02 Drawings**

The examination of the drawing during initial examination, before submission of an allegation of use and specimen, will focus primarily on the form of the drawing and compliance with 37 C.F.R. §2.52. Intent-to-use applicants must comply with all formal requirements related to drawings, whether typed or in special form. *See* TMEP §§807 *et seq.* The examination of the drawing after submission of an amendment to allege use is discussed in TMEP §1104.09(f), and the examination of the drawing after submission of a statement of use is discussed in TMEP §1109.12. The applicant may not amend the mark in a drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2).

### **1102.03 Intent-to-Use Applications and the Supplemental Register [R-1]**

An applicant who relies on a bona fide intention to use the mark in commerce under §1(b) may not seek registration on the Supplemental Register until the applicant has submitted an amendment to allege use that meets the minimum filing requirements of 37 C.F.R. §2.76(e) or a statement of use that meets the minimum filing requirements of 37 C.F.R. §2.88(e). 37 C.F.R. §§2.47(c) and 2.75(b). Only applications under §44 of the Trademark Act, 15 U.S.C. §1126, are excepted from the use requirement in seeking registration on the Supplemental Register.

If an intent-to-use application requests registration on the Supplemental Register, the examining attorney will refuse registration under §23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the mark is not in lawful use in commerce. If an application is based on intent-to-use in addition to another basis, registration of the entire application will be refused on the Supplemental Register unless the applicant either deletes the §1(b) basis or files a request to divide. *See* TMEP §§1110 *et seq.* regarding requests to divide. The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use.

If an application is based solely on §1(b), and the applicant files an acceptable amendment to allege use or statement of use *and* an acceptable amendment to the Supplemental Register, the Office will consider the filing date of the amendment to allege use or statement of use to be the effective filing date of the application. 37 C.F.R. §2.75(b); TMEP §206.01. The examining attorney must conduct a new search of Office records for conflicting marks.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The examining attorney should examine the amendment to allege use or statement of use before taking action on the amendment to the Supplemental Register.

See TMEP §§815 and 816 *et seq.* for additional information about the Supplemental Register.

### **1102.04 Claims of Acquired Distinctiveness under §2(f)**

See TMEP §§1212.09 *et seq.* regarding claims of distinctiveness under §2(f), 15 U.S.C. §1052(f), in intent-to-use applications.

### **1103 Allegations of Use**

While §1(b) of the Trademark Act provides for *filing* an application based on the applicant's bona fide intent to use the mark in commerce, registration cannot be granted until the applicant files an allegation of use (*i.e.*, either an amendment to allege use under §1(c) of the Act or a statement of use under §1(d) of the Act). The allegation of use must include verified dates of first use (*see* TMEP §903), and a specimen of use for each class of goods or services (*see* TMEP §§904 *et seq.*).

The allegation of use can be filed electronically using the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov>. See TMEP §301 for additional information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199 to obtain a form ("Trademark/Service Mark Allegation of Use") that can be used to file either an amendment to allege use or a statement of use via mail, fax or hand delivery.

The principal difference between the amendment to allege use and the statement of use is the time of filing. The amendment to allege use may be filed after the application filing date but before approval of the mark for publication. 37 C.F.R. §2.76(a); TMEP §1104.03. If the applicant does not file an acceptable amendment to allege use during initial examination or if an amendment to allege use is filed and withdrawn, and the Office issues a notice of allowance under 15 U.S.C. §1063(b)(2) (*see* TMEP §§1106 *et seq.*), the applicant must file a statement of use within six months of the mailing date of the notice of allowance or within an extension of time granted for filing of the statement of use. 15 U.S.C. §1051(d). See TMEP §§1109 *et seq.* regarding statements of use.

The applicant may *not* file the allegation of use after approval of the mark for publication and before issuance of the notice of allowance. 37 C.F.R. §2.88(a); TMEP §1104.03.

### **1104 Amendment to Allege Use Under §1(c) of the Act**

As stated earlier, an intent-to-use applicant must file either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) before

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

issuance of the registration. This section pertains only to amendments to allege use. Statements of use are discussed in TMEP §§1109 *et seq.*

Filing an amendment to allege use does not relieve the applicant of the duty to file a response to an outstanding Office action or to take any other action required in the case, including filing a notice of appeal. *See* TMEP §1104.07 regarding the filing of an amendment to allege use in conjunction with an appeal.

### **1104.01 Minimum Requirements for Filing an Amendment to Allege Use**

The amendment to allege use must include the following minimum elements to be referred to the examining attorney for examination on the merits:

- (1) the prescribed fee for at least one class;
- (2) one specimen or facsimile of the mark as used in commerce; and
- (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

37 C.F.R. §2.76(e).

*See* TMEP §1104.08 regarding the necessary elements in a complete amendment to allege use.

### **1104.01(a) Review by Legal Instruments Examiner for Compliance with Minimum Filing Requirements**

The legal instruments examiner in the law office will conduct a preliminary review of an amendment to allege use to determine whether it is timely and complies with the minimum requirements of 37 C.F.R. §2.76(e). If the amendment to allege use is timely and complies with the minimum requirements, the legal instruments examiner will refer the amendment to allege use to the responsible examining attorney for examination on the merits. *See* TMEP §§1104.09 *et seq.* regarding examination by the examining attorney.

*See* TMEP §1104.01(b) regarding processing an amendment to allege use that does not meet minimum filing requirements, and TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

### **1104.01(b) Processing an Amendment to Allege Use That Does Not Meet Minimum Filing Requirements**

If an amendment to allege use is timely, but does not comply with the minimum requirements of 37 C.F.R. §2.76(e) (*see* TMEP §1104.01), the legal instruments examiner will advise the applicant in writing of the deficiency. The applicant may correct the deficiency, provided the applicant does so before the mark is approved for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

publication. *See* 37 C.F.R. §2.76(g). If an acceptable amendment to correct the deficiency is not filed before the mark is approved for publication, the amendment to allege use will not be examined. 37 C.F.R. §2.76(g).

If the filing fee for at least a single class is omitted or is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, if an authorization to charge the fee to a credit card is refused or charged back by a financial institution, or if the check submitted as payment of the filing fee is returned unpaid), the legal instruments examiner will advise the applicant that the applicant must repay the fee before the mark is approved for publication, or the amendment to allege use will not be examined. In addition, when a fee charged to a credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §1.21(m). This processing fee must be paid even if the applicant withdraws the amendment to allege use. *See* TMEP §405.01(a) regarding credit card charges that are refused, TMEP §405.02(a) regarding returned checks, and TMEP §405.03 regarding deposit accounts.

If the amendment to allege use does not include a specimen, the legal instruments examiner will advise the applicant that the applicant must submit a specimen, supported by an affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen is in use in commerce in connection with the goods and/or services, before the mark is approved for publication, or the Office will not examine the amendment to allege use.

If the amendment to allege use is not signed, the legal instruments examiner will advise the applicant that the applicant must submit a properly signed amendment to allege use before the mark is approved for publication, or the Office will not examine the amendment to allege use.

After notifying the applicant that an amendment to allege use does not meet the minimum filing requirements, the legal instruments examiner should place the informal amendment to allege use in the file with a copy of the relevant action advising the applicant of the deficiency or deficiencies. If the applicant does not correct all deficiencies before approval of the mark for publication, the examining attorney will not examine the amendment to allege use. In such a case, if the applicant has submitted the fee, the fee will not be refunded and cannot be applied to a later-filed statement of use. If the mark is published for opposition, the applicant may file a statement of use after the notice of allowance issues.

If the applicant wishes to establish that the amendment to allege use as filed met the minimum requirements of 37 C.F.R. §2.76(e), the applicant must file a petition under 37 C.F.R. §2.146. In addition to the petition fee (37 C.F.R. §2.6), the petition should include a copy of the amendment to allege use and specimen, and any evidence establishing that the amendment to allege use as filed met the minimum filing requirements. Chapter 1700 for additional information about petitions. If the petition is granted, the amendment to allege use will be considered filed on the date it was originally received in the Office.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

See TMEP §1104.03(c) regarding processing an untimely amendment to allege use.

### **1104.01(c) Processing Defective Amendment to Allege Use Filed With Other Amendments**

After the legal instruments examiner has taken appropriate action on the amendment to allege use (*see* TMEP §1104.01(b)), the legal instruments examiner will process any other amendments filed with the amendment to allege use and will refer the case to the responsible examining attorney for appropriate action on those other amendments.

If the amendment to allege use did not meet the minimum requirements of 37 C.F.R. §2.76(e), the examining attorney will act on any other amendments in the case without considering the amendment to allege use. The examining attorney should issue requirements or refusals according to standard examination procedure without considering the amendment to allege use. Any specimen submitted becomes part of the record and may be relied on in relation to issues unrelated to use.

If the examining attorney determines that the legal instruments examiner erred in holding that the amendment to allege use did not meet the minimum requirements of 37 C.F.R. §2.76(e), the examining attorney should telephone to advise the applicant that the amendment to allege use will be examined on the merits and to disregard the legal instruments examiner's action.

### **1104.02 Form of Amendment to Allege Use**

To expedite processing, the Office recommends that an applicant file an amendment to allege use electronically using the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov>. *See* TMEP §301 for more information about electronic filing. Alternatively, the owner can call the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199 to obtain a pre-printed form that can be used to file either a statement of use or amendment to allege use (“Trademark/Service Mark Allegation of Use).” The applicant may mail, fax or hand-deliver the completed form to the Office. If the form is faxed or filed electronically, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account.

If the applicant does not file electronically or use the form designed by the Office, the applicant should submit the amendment to allege use in a document separate from other amendments, with the title “Amendment to Allege Use” appearing at the top of the first page. 37 C.F.R. §2.76(d). However, this format is not mandatory. The Office will accept and enter any paper that includes an amendment to allege use if it meets the minimum filing requirements set forth in 37 C.F.R. §2.76(e), regardless of whether it is properly titled or includes other amendments. The Office will process the form even if it is captioned as a “Statement of Use,” as long as it is filed before the examining attorney approves the mark for publication.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §1104.01 regarding the minimum requirements that must be met before an amendment to allege use can be referred to an examining attorney for examination, and TMEP §1104.08 regarding the necessary elements in a complete amendment to allege use.

### **1104.03 Time for Filing Amendment to Allege Use**

Under 37 C.F.R. §2.76(a), an applicant may file an amendment to allege use at any time between the application filing date and the date the examining attorney approves the mark for publication.

An amendment to allege use may be filed after commencement of an *ex parte* appeal. See TMEP §1104.07.

An applicant may not file either an amendment to allege use or a statement of use between the date the examining attorney approves the mark for publication and the date of issuance of the notice of allowance. This period, during which no allegation of use can be filed, is known as the “blackout period.” See TMEP §§1104.03(b) and (c).

### **1104.03(a) Use on All Goods Required Before Filing**

An applicant may not file an amendment to allege use until the applicant has used the mark in commerce on or in connection with *all* goods/services for which the applicant seeks registration under §1(b), unless the applicant files a request to divide. 37 C.F.R. §2.76(c). If the applicant files an amendment to allege use before using the mark on or in connection with all the goods/services, but does not file a request to divide, the applicant will be required to: (1) withdraw the amendment to allege use (see TMEP §1104.10); (2) delete the goods/services not covered by the amendment to allege use from the application; or (3) file a request to divide out the goods/services that are not yet in use. See TMEP §§1110 *et seq.* regarding requests to divide.

### **1104.03(b) The “Blackout Period”**

Under 37 C.F.R. §2.76(a), an applicant may not file an amendment to allege use under 15 U.S.C. §1051(c) after the date that the application is approved for publication by the examining attorney. Under 37 C.F.R. §2.88(a), an applicant may not file a statement of use under 15 U.S.C. §1(d) before the issuance of the notice of allowance. These two rules combine to create a period of time when neither an amendment to allege use nor a statement of use can be filed. This period is known as the “blackout period.” Any statement of use or amendment to allege use filed during this period will be deemed untimely and returned to applicant. *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm’r Pats. 1991). See TMEP §1104.03(c) regarding processing allegations of use filed during the blackout period.

Intent-to-use applicants are encouraged to check the Trademark Applications and Registrations Retrieval (TARR) database on the Office’s website at

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

<http://tarr.uspto.gov/>, or to call the Trademark Status Line at (703) 305-8747, to determine the status of the application before filing an amendment to allege use. See TMEP §108.01 for further information about the TARR database, and TMEP §108.02 for further information about the status line.

If the status check indicates that the status of the application is any of the following, then the blackout period is in effect because the mark has been approved for publication and a notice of allowance has not yet issued:

- Approved for Publication (by the examining attorney)
- Publication/Registration review complete (by the law office clerk)
- Published for Opposition
- Notice of Allowance—Withdrawn
- Notice of Allowance—Cancelled
- Withdrawn from publication
- Withdrawn from registration—Jurisdiction restored (to the examining attorney)
- Withdrawn from registration
- Cancelled—Restored to Pendency (indicates subject registration number was issued inadvertently and correction requires restoration of the application to pendency)
- Inadvertently issued registration number—Cancelled (indicates the subject registration number was issued inadvertently and has been cancelled)
- Concurrent use proceeding terminated—granted
- Concurrent use proceeding terminated—denied
- Concurrent use proceeding pending
- Interference proceeding pending
- Interference proceeding terminated
- Opposition pending
- Opposition dismissed
- Opposition dismissed—See TTAB records
- Opposition sustained
- Opposition instituted
- Request for extension of time to file opposition
- Amendment after publication

If the reported status is one of those listed above, then the blackout period has begun and the applicant should *not* file the amendment to allege use. On the other hand, if the reported status is not one of those listed above, the applicant may file the amendment to allege use.

It is possible that the mark could be approved for publication on the same day but shortly after the applicant checks the status of the application. However, the blackout period does not begin until the day *after* a mark is approved for publication.

**1104.03(c) Processing Amendments to Allege Use Filed During the Blackout Period**

If an applicant files an amendment to allege use during the blackout period, the legal instruments examiner will normally return the amendment to allege use and any fees to the applicant, with a notice advising the applicant that the amendment to allege use is untimely and will not be processed. If the late amendment to allege use was filed on the same paper with other amendments, the legal instruments examiner will retain the papers and will advise the applicant that the amendment to allege use is late and must be resubmitted as a statement of use after the notice of allowance issues. The legal instruments examiner will arrange a refund of the filing fee for the amendment to allege use.

The examining attorney should not cancel the approval or withdraw the application from publication to process the untimely amendment to allege use. Furthermore, the examining attorney should not suspend action in the case or take any other similar action to extend the time for filing an amendment to allege use.

The Office will not retain an untimely amendment to allege use and process it as a statement of use. However, the applicant may resubmit an untimely amendment to allege use as a statement of use after the notice of allowance issues. TMEP §1109.05(a).

**1104.04 Processing Timely Amendments to Allege Use Located After Publication**

If an amendment to allege use is timely (*see* TMEP §1104.03) and complies with the minimum requirements to be referred for examination on the merits (TMEP §1104.01), but the mark was published for opposition before the amendment to allege use was associated with the file, the Office will process the paper as follows.

The examining attorney will contact the applicant or the applicant's attorney by telephone or e-mail (if the applicant has authorized e-mail communications) to give the applicant the opportunity to withdraw the amendment to allege use. The examining attorney should advise the applicant that the application will be withdrawn from publication if the amendment to allege use is not withdrawn.

*Amendment to Allege Use Withdrawn*

If the applicant withdraws the amendment to allege use, the examining attorney should advise applicant that a notice of allowance will issue if the application is not opposed, or if it survives any opposition(s) filed, and that the applicant must file a statement of use (or request for extension of time to file a statement of use) within six months after the mailing date of the notice of allowance. The examining attorney should advise applicant that, instead of filing a statement of use, the applicant may file a written request that the Office treat the amendment to allege use as a statement of use. Such a request *must be filed within six months after the mailing date of the notice of allowance*, and may be faxed to the ITU/Divisional Unit of the Office at

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

(703) 308-7196. The examining attorney should place the amendment to allege use in the application file and make a note to the file reflecting the substance of the communication with the applicant.

The applicant has the option of receiving a refund of the filing fee for the amendment to allege use, or applying the fee toward a statement of use. If the applicant requests a refund, the examining attorney should ask the legal instruments examiner in the law office to arrange for a refund of the fee.

Because §1(d)(1) of the Trademark Act, 15 U.S.C. §1051(d)(1), explicitly requires that a statement of use be filed within six months *after* the issuance of the notice of allowance, the Office cannot process the amendment to allege use as a statement of use unless the applicant files a written request within six months after the mailing date of the notice of allowance. If the applicant does not file a statement of use, or a written request to treat the amendment to allege use as a statement of use, within six months after the mailing date of the notice of allowance, the application will be abandoned, even if the amendment to allege use is still in the file and the filing fee for the amendment to allege use has not been refunded.

### *Amendment to Allege Use Not Withdrawn*

If the applicant does not withdraw the amendment to allege use, the examining attorney should make an appropriate note to the file, and should then examine the amendment to allege use. If the amendment to allege use can be approved, and does not raise any issues that require the examining attorney to issue an Office action that requires a response, the examining attorney should approve the amendment to allege use (*see* TMEP §1104.11). The mark must be republished.

If examination of the amendment to allege use raises issues that would require the examining attorney to raise requirements or refusals in a form other than an examiner's amendment, the examining attorney should request jurisdiction for the purpose of issuing the relevant requirements or refusals. *See* TMEP §1504.04(a). The proposed Office action setting forth the relevant requirements or refusals should accompany the request for jurisdiction. If the applicant ultimately complies with all requirements and overcomes all refusals, the mark must be republished.

### *Applications That are the Subject of an Opposition or Request for Extension of Time to Oppose*

If the application is under an extension of time to file an opposition when the amendment to allege use is associated with the application, the Board will suspend the running of any granted extension and will return the application to the examining attorney for processing in accordance with the procedures explained above. If the amendment to allege use is ultimately approved or withdrawn, the application should be returned to the Board for appropriate handling. TBMP §219.

If a notice of opposition has been filed when the amendment to allege use is associated with the application, the Board will usually suspend the opposition

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

proceeding and remand the application to the examining attorney for examination of the amendment to allege use. The examining attorney should follow the procedures explained above, except that no request for jurisdiction is necessary. If the amendment to allege use is ultimately approved or withdrawn, the application should be returned to the Board for appropriate action. TBMP §219.

### **1104.05 Amendments to Allege Use Filed in Conjunction With Application**

If an applicant files an intent-to-use application under 15 U.S.C. §1051(b), and, at the same time, an amendment to allege use asserting dates of use before the filing date of the application, the applicant will be required to comply with all requirements related to the amendment to allege use, including the payment of the required fees for all classes.

### **1104.06 Processing Amendments to Allege Use Received Before Application is Assigned to an Examining Attorney**

If an amendment to allege use is received before an application has been assigned to an examining attorney, the legal instruments examiner will review the amendment to allege use to determine whether it complies with the minimum requirements of 37 C.F.R. §2.76(e) and will take appropriate action. *See* TMEP §§1104.01 *et seq.* The legal instruments examiner will then return the case to the new case docket.

### **1104.07 Amendments to Allege Use and *Ex Parte* Appeals**

An amendment to allege use may be filed together with a notice of appeal to the Trademark Trial and Appeal Board, or it may be filed while an appeal is pending.

Once the appeal is filed, the Board has jurisdiction over the application. If the applicant files the amendment to allege use *with* the notice of appeal, the Board will institute the appeal, suspend action on the appeal, and remand the case to the examining attorney to examine the amendment to allege use. When the applicant files the amendment to allege use *after* commencement of the appeal, the Board may in its discretion suspend action on the appeal and remand the application to the examining attorney for consideration of the amendment to allege use, or it may continue action on the appeal, thus deferring examination of the amendment to allege use until after disposition of the appeal.

If the Board remands the application, the examining attorney should continue examination according to standard examining procedures until final resolution of any new issues that arise in the examination of the amendment to allege use. If all issues are resolved or made the subject of a final action, the examining attorney should return the application to the Board for resumption of the appeal. TBMP §1206.01.

If the examining attorney withdraws the refusal or requirement that is the subject of the appeal, he or she should advise the applicant or the applicant's attorney by

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

telephone or by e-mail (if the applicant has authorized e-mail communications), and make an appropriate note to the file.

### **1104.08 Necessary Elements in a Complete Amendment to Allege Use**

The *complete* amendment to allege use must include the following elements:

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the date of the applicant's first use of the mark anywhere and first use of the mark in commerce, and a listing of those goods/services specified in the application on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce that meets the requirements of 37 C.F.R. §2.56; and
- (3) the prescribed fee for each class (37 C.F.R. §2.6).

37 C.F.R. §2.76(b).

### **1104.09 Examination of Amendment to Allege Use by Examining Attorney**

If a timely filed amendment to allege use meets the minimum requirements of 37 C.F.R. §2.76(e) (*see* TMEP §1104.01), the legal instruments examiner will forward the amendment to allege use to the examining attorney for examination. The examining attorney will examine the amendment to allege use, in turn, with other amended cases.

The examining attorney must examine the amendment to allege use for compliance with all relevant sections of the Act. The clear-error standard that limits the issues that may be raised in examination of a statement of use (*see* TMEP §1109.08) does not apply to the examination of an amendment to allege use.

The following sections present examples of issues that should be considered during examination of the amendment to allege use. These sections do not exhaust all possibilities, but rather present a general framework governing the areas for examination.

#### **1104.09(a) Ownership**

The examining attorney must confirm that the proper party has filed the amendment to allege use. Only the applicant or a valid assignee under §10 of the Trademark Act, 15 U.S.C. §1060, can file an amendment to allege use.

If the party filing the amendment to allege use is the owner at the time of filing, but the records of the Office show title in another party, the applicant may submit evidence to establish chain of title within the response period specified in the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

examining attorney's Office action. *See* 37 C.F.R. §§3.71 and 3.73; TMEP §502. To establish ownership, the party who filed the amendment to allege use must either: (1) record an assignment or other document of title with the Assignment Services Division, and notify the Trademark Operation that the document has been recorded, specifying the reel and frame number at which the document is recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.

If the party filing the amendment to allege use was not the owner of the mark at the time of filing the amendment to allege use, the examining attorney should not approve the amendment to allege use. The true owner may file a substitute amendment to allege use (including a filing fee) on or before the date the application is approved for publication.

If there has been a change of ownership and the new owner wants the registration certificate to issue in the new name, the new owner must record a document with the Assignment Services Division *and* notify the Trademark Operation that the document has been recorded. 37 C.F.R. §3.85; TMEP §502.01. *See also* TMEP §502.01(a) regarding an examining attorney's handling of an application after the mark has been assigned.

### **1104.09(b) Verification and Date of Execution**

The verification should be signed by the applicant or a person properly authorized to sign on behalf of the applicant. 37 C.F.R. §2.76(b)(1). *See* 37 C.F.R. §2.33(a) and TMEP §804.04 as to who is properly authorized to sign on behalf of an applicant. Generally, the Office will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign.

If the amendment to allege use is not filed within one year after it is signed, the examining attorney will require a substitute or supplemental verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.76(i); TMEP §804.03.

*See* TMEP §§301 and 804.05 regarding signature of electronically filed documents.

### **1104.09(c) Identification of Goods or Services**

The examining attorney must examine the identification of goods/services in an amendment to allege use to ensure that it conforms to the goods/services specified in the application. The applicant may limit or clarify the goods/services, but may not add to or expand the identification. 37 C.F.R. §2.71(a).

If the applicant has not specified the goods and services in the amendment to allege use, as required by 37 C.F.R. §2.76(b), or if the goods and services specified in the

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

amendment to allege use exceed the scope of the goods and services specified in the application, the examining attorney must require amendment.

If goods or services identified in the application are omitted from the amendment to allege use, but the applicant has not specifically indicated an intention to delete those goods/services from the application, the examining attorney should confirm that the applicant intends to delete the omitted goods/services. The applicant may amend the amendment to allege use to claim use on or in connection with the goods/services that were omitted, provided the applicant did not expressly delete the goods/services by amendment and provided the applicant verifies that it has used the mark in commerce on or in connection with the goods/services in an affidavit or declaration under 37 C.F.R. §2.20. Inadvertently omitted goods or services may not be reinserted by examiner's amendment, because verification is required.

Omission of goods/services in an amendment to allege use or statement of use is the only instance when an applicant may reinsert goods or services. Goods or services once expressly deleted by amendment, or omitted from the identification of goods and services in a request for an extension of time to file a statement of use, may not be reinserted by later amendment. TMEP §1402.07.

If an amendment of the identification of goods/services results in the addition of class(es) to the application after an amendment to allege use is filed, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es).

### **1104.09(d) Use in Commerce and Dates of Use**

An amendment to allege use must include a verified statement that the mark is in use in commerce, and must specify the date of the applicant's first use of the mark and first use of the mark in commerce for each class of goods/services. 37 C.F.R. §2.76(b)(1)(ii). The applicant may amend the dates of use if the applicant supports the amendment with an affidavit or declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.71(c). The applicant may not amend the dates of use to recite dates of use that are subsequent to the filing of the amendment to allege use. However, the applicant may withdraw the amendment to allege use. 37 C.F.R. §2.76(h).

### **1104.09(e) Specimen [R-1]**

An amendment to allege use must include a specimen for each class of goods or services. The examining attorney must review the specimen for compliance with all relevant requirements. *See* TMEP §904.04 regarding material that is appropriate as a trademark specimen, TMEP §§1301.04 *et seq.* regarding material that is appropriate as a service mark specimen, and TMEP §§1202 *et seq.* and 1301.02 *et seq.* regarding use as a mark.

If the applicant submits a substitute specimen in conjunction with an amendment to allege use, the applicant must verify that the applicant used the substitute specimen in

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

commerce on or in connection with the goods and/or services prior to filing the amendment to allege use. If in fact the mark was first used on dates other than those asserted in the amendment to allege use, the dates of use must be corrected. *See* TMEP §§903.05 and 1104.09(d) regarding amendment of the dates of use.

If the amendment to allege use is filed electronically using TEAS, the applicant must submit the specimen via a digitized image (*e.g.*, .gif or .jpg) file. 37 C.F.R. §2.56(d)(4). *See* TMEP §904.02 for additional information about electronically filed specimens.

### **1104.09(f) Drawing**

Under 37 C.F.R. §2.51(a)(2), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and* as actually used as shown on the specimen filed with the amendment to allege use or statement of use. An applicant may not amend the mark in the original drawing if the amendment constitutes a material alteration of the mark. 37 C.F.R. §2.72(b)(2); TMEP §807.14(a). The same standards that apply to use applications in determining whether specimens support use of the mark and whether amendments to the drawing can be permitted also apply in the examination of an amendment to allege use.

Therefore, if the mark in the drawing filed with the original application is not a substantially exact representation of the mark as used on the specimen filed with the amendment to allege use, the examining attorney must require: (1) *either* submission of a new specimen *or* an amendment of the mark in the drawing, if the amendment of the mark would not be a material alteration of the mark on the original drawing; or (2) submission of a new specimen, if the amendment of the mark would be a material alteration of the mark on the original drawing. 37 C.F.R. §2.72(b)(2). *See* TMEP §807.14(a) regarding material alteration.

### **1104.09(g) Fees**

While the payment of the fee for at least one class is enough to meet the minimum filing requirements for an amendment to allege use (37 C.F.R. §2.76(e)), the examining attorney must require payment of fees to cover *all* classes identified in the application before approving the amendment to allege use. The applicant may amend the identification to delete classes.

If class(es) are added to the application after the filing of the amendment to allege use, the examining attorney must require payment of the fee(s) for filing the amendment to allege use in the added class(es).

If the applicant submits a filing fee that is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, if an authorization to charge the fee to a credit card is refused or charged back by a financial institution, or if the check submitted as payment of the filing fee is returned unpaid), the examining attorney must require repayment of the fee before approving the mark for publication. In

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

addition, when a fee charged to a credit card is refused or a check is returned unpaid, the examining attorney must require a \$50 processing fee under 37 C.F.R. §1.21(m). This processing fee must be paid even if the applicant withdraws the amendment to allege use. *See* TMEP §405.01(a) regarding credit card charges that are refused or charged back, TMEP §405.02(a) regarding returned checks, and TMEP §405.03 regarding deposit accounts.

### **1104.09(h) Issuance of Actions by Examining Attorney Related to the Amendment to Allege Use**

If the legal instruments examiner reviews an amendment to allege use and refers it to the examining attorney for examination on the merits, the examining attorney should examine the amendment to allege use.

If the examining attorney determines that the amendment to allege use is not acceptable, or that it raises new issues in the case, the examining attorney will issue an action stating all refusals and requirements arising in the examination of the amendment to allege use and incorporating all unresolved issues from any outstanding Office action in the case. The examining attorney's action related to the amendment to allege use supersedes any outstanding Office action, and the applicant's response on all issues is due six months from the date of the new action. The new action must be nonfinal, because those issues arising from the examination of the amendment to allege use will have been raised for the first time.

If the amendment to allege use was referred for examination before the case was assigned to the examining attorney, the examining attorney will examine the application as a whole, including the amendment to allege use, and will issue a first action addressing all issues in the case.

If the application is suspended, the examining attorney should examine the amendment to allege use. If any action is required, the examining attorney should remove the application from suspension and take appropriate action. Any refusals or requirements that were operative at the time of suspension should be incorporated in the examining attorney's action.

If the amendment to allege use is referred for examination on the merits at the same time as a response, or if it is referred for examination when the application is in the examining attorney's amended docket after receipt of a response, the examining attorney should consider both the response and the amendment to allege use.

If the amendment to allege use is acceptable in all respects, the examining attorney should approve the amendment to allege use and take whatever action is necessary on the response. *See* TMEP §1104.11 regarding approval of the amendment to allege use.

*See* TMEP §1104.07 regarding amendments to allege use filed with a notice of appeal or after the commencement of an appeal.

**1104.10 Amendment and Withdrawal of Amendment to Allege Use**

The applicant may amend the amendment to allege use to correct deficiencies, to overcome a refusal, to comply with a requirement, or for any other purpose.

The applicant may withdraw the amendment to allege use at any time before approval of the mark for publication. 37 C.F.R. §2.76(h). The Office will *not* refund the fee for filing an amendment to allege use that is withdrawn, and the papers and specimen(s) filed with the amendment to allege use will remain part of the record.

The applicant may authorize the examining attorney to issue an examiner's amendment that withdraws the amendment to allege use.

If the applicant withdraws the amendment to allege use, the application will be processed as an intent-to-use application subject to publication and issuance of a notice of allowance. After issuance of the notice of allowance, the applicant must file a statement of use.

If the applicant wishes to request withdrawal of an amendment to allege use during an *ex parte* appeal, the applicant should direct the request to the Trademark Trial and Appeal Board.

If the applicant withdraws the amendment to allege use, the examining attorney will withdraw any requirements or refusals specifically related to use of the mark, such as objections related to the form of the verified statement itself, the agreement of the mark as used on the specimens with the mark shown on the drawing, or the use of the applied-for designation as a trademark or service mark evidenced by the specimen. The examining attorney should also withdraw any requirement or refusal related to the execution of the amendment to allege use.

The examining attorney should maintain any requirement or refusal arising from the amendment to allege use not specifically related to the dates of use or use of the mark, such as refusals or requirements related to ownership or refusals under 15 U.S.C. §1052(e)(1), §1052(e)(2), §1052(e)(3) or §1052(e)(4). The specimens or any other submission related to the amendment to allege use will remain part of the record and may be relied on to support refusals and requirements under these sections.

If the applicant withdraws the amendment to allege use after it has been approved, the examining attorney must withdraw the approval on the Office's automated TRAM (Trademark Reporting and Monitoring) system.

**1104.11 Approval of Amendment to Allege Use After Examination  
[R-2]**

The examining attorney should approve the amendment to allege use if it complies with the requirements specified in 37 C.F.R. §§2.76(b) and (c). The amendment to allege use should be approved even if requirements or refusals unrelated to §2.76(b) or (c) are necessary as a result of the examination of the amendment to allege use.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

*Approval of the amendment to allege use does not signify that the application is in condition for approval for publication.*

The examining attorney should *not* approve the amendment to allege use if it does not meet the requirements of 37 C.F.R. §§2.76(b) and (c), *e.g.*, if the applicant has not provided a specimen and fee for each class, or if the goods/services in the amendment to allege use do not conform to the goods/services specified in the application.

On the other hand, if the amendment to allege use meets the requirements of 37 C.F.R. §§2.76(b) and (c), but requirements or refusals related to the ownership of the mark, use of the mark, inconsistencies between the mark in the drawing and the mark on the specimens, or other matters require action, the examining attorney should approve the amendment to allege use and then take action on those other issues. For example, if the specimen shows ornamental use of the proposed mark, the examining attorney should approve the amendment to allege use and issue a refusal based on ornamental use of the proposed mark.

When approving an amendment to allege use, the examining attorney must perform the appropriate TRAM transaction to ensure that a computer-generated notice is issued advising the applicant that the amendment to allege use has been approved and that the application will be published in the same manner as a use-based application. In other words, publication in the *Official Gazette* will include dates of use and, if the applicant survives the opposition period, the Office will issue a certificate of registration rather than a notice of allowance.

### **1105 Publication of Intent-to-Use Applications for Opposition**

If an amendment to allege use has been submitted and accepted, the intent-to-use application is processed in the same manner as a use application. If the examining attorney determines that the mark is entitled to registration, the examining attorney will approve the mark for publication and the mark will be published for opposition. If the application is not opposed or survives all oppositions filed, the mark will register.

If no amendment to allege use has been accepted for an intent-to-use application, and the examining attorney determines that the mark is entitled to registration but for the submission of an allegation of use, the examining attorney will approve the mark for publication and the mark will be published for opposition. If the application is not opposed or survives all oppositions filed, the Office will issue a notice of allowance. 15 U.S.C. §1063(b)(2); 37 C.F.R. §2.81(b).

### **1106 Notice of Allowance**

#### **1106.01 Issuance of the Notice of Allowance**

Section 13(b)(2) of the Trademark Act, 15 U.S.C. §1063(b)(2), provides for issuance of a notice of allowance if a §1(b) application is published for opposition and is not opposed, or survives any opposition(s) filed. The notice of allowance in an intent-to-

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

use application will issue on the same date that a registration would issue in a use application (normally 12 weeks after the date of publication). The Office does not publish any notification that a notice of allowance has been issued in the *Official Gazette*.

The notice of allowance will list the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods/services, and the date of issuance of the notice of allowance. 37 C.F.R. §2.81(b). The notice of allowance is a key document because its issue date establishes the due date for filing a statement of use. The accuracy of the information stated on the notice of allowance is important. If there are any errors in the notice of allowance, the applicant should notify the ITU/Divisional Unit immediately. *See* TMEP §1106.04.

If an applicant asserts other bases for registration in addition to §1(b), the Office will publish the mark for opposition and will issue a notice of allowance if there is no successful opposition. The goods/services for all the bases will remain in the application pending the filing and approval of a statement of use for the goods/services based on §1(b), unless the applicant files a request to divide. *See* TMEP §§1110 *et seq.* regarding requests to divide. If the applicant fails to timely file a statement of use or a request for an extension of time to file a statement of use in response to a notice of allowance, the entire application will be abandoned, unless the applicant files a request to divide before the expiration of the deadline for filing the statement of use. TMEP §806.02(d). The applicant may file a petition to revive if the delay in filing the statement of use or extension request was unintentional. *See* TMEP §§1714 *et seq.*

### **1106.02            Action by Examining Attorney After Issuance of the Notice of Allowance**

If, after issuance of the notice of allowance but before submission of the statement of use, the Office determines that a clear error was made in approving the mark for publication, the Office will cancel the notice of allowance and return the application to examination. The examining attorney will issue an appropriate Office action that includes the relevant requirement or refusal and informs the applicant of the cancellation of the notice of allowance. *See* TMEP §1106.03 regarding cancellation of the notice of allowance.

After the notice of allowance issues, the examining attorney has jurisdiction to act in the case. 37 C.F.R. §2.84(a). Therefore, the examining attorney does not have to request jurisdiction to take an action in the case, as would be required to take an action after publication but before the notice of allowance issues. However, after a notice of allowance issues, the examining attorney should not make a refusal or requirement that could or should have been made during initial examination of the application unless the initial failure to make the refusal or requirement was a clear error. *See* TMEP §1109.08 regarding the “clear error” standard. If, after the notice of allowance issues, the examining attorney determines that he or she must make a refusal or requirement that could or should have been made during initial examination

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

of the application, the examining attorney should consult the managing attorney or senior attorney before taking any such action. This must be done whether the action is to be taken before, during or after examination of the statement of use, and regardless of whether the notice of allowance is cancelled. This applies to any refusal that arguably could or should have been made during initial examination, such as most refusals under §2(d) or §2(e)(1) of the Act.

### **1106.03 Cancellation of Notice of Allowance**

If the Office cancels the notice of allowance to take action in an application before the filing or examination of the statement of use, the Office will refund any fees paid in conjunction with a statement of use or request(s) for extension(s) of time to file a statement of use.

Cancellation of the notice of allowance is handled by the ITU/Divisional Unit of the Office.

When the notice of allowance is cancelled, the application is returned to initial examination. The examining attorney does not have to request jurisdiction to issue an Office action. If the applicant overcomes the refusal or complies with the requirement, the examining attorney may approve the mark for publication again. The mark must be republished.

If the application is returned to initial examination, any statement of use that had previously been submitted will be retained in the file but will not be examined unless it is resubmitted with the required fee as an amendment to allege use or statement of use at the appropriate time.

### **1106.04 Correction of Errors in Notice of Allowance**

When the applicant receives a notice of allowance, the applicant should check the accuracy of the information. If there are any errors in the notice of allowance, the applicant should notify the ITU/Divisional Unit of the Office immediately, preferably by fax or telephone.

#### *Correction of Office Error*

If an error in the notice of allowance was the result of an Office error (*e.g.*, entering data incorrectly or failing to enter a timely filed amendment), the Office will determine whether the change requires republication. If necessary, the ITU Unit will forward the file to the examining attorney to approve the change and determine whether republication is required.

If the change can be made without republication, the ITU Unit will make the correction. *The Office will not issue a new notice of allowance or extend the time for filing a statement of use.*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If republication is required, and no action by the examining attorney that requires a response is necessary, the ITU Unit will make the correction, cancel the notice of allowance, and refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use. The ITU Unit will then send the file to the Publication and Issue Section of the Office to be republished. If the application is not opposed or survives all oppositions filed, the Office will issue a new notice of allowance.

If the examining attorney must issue an Office action that requires a response as a result of the requested correction, the ITU Unit will cancel the notice of allowance, refund any fees paid for filing a statement of use or request(s) for extension of time to file a statement of use, and send the file to the examining attorney for further action.

### *Correction of Applicant's Error*

If an error in the notice of allowance is the result of an applicant's error (*e.g.*, providing incorrect information in the application or in an amendment to the application), the applicant must file a written amendment, which will be processed like any other amendment filed after issuance of the notice of allowance and before filing of the statement of use. *See* TMEP §1107.

### **1107                      Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use [R-2]**

Generally, the only amendments that can be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are (1) the deletion of specified goods/services from the identification of goods and services (37 C.F.R. §2.77), (2) the deletion of a basis in a multi-basis application (37 C.F.R. §2.35(a)), and (3) changes of attorney and changes of address.

“Deletion,” within the meaning of 37 C.F.R. §2.77, means the elimination of an existing item in an identification of goods and services in its entirety. Deletion is distinct from other types of amendments to limit an identification, such as amendments to limit the goods as to types, channels of trade or class of purchasers, or to restrict an existing item in scope by the introduction of some qualifying language or the substitution of specific for more general terms.

The Office will normally not consider any other amendment to the application during this period. If the applicant submits any other amendment during this period, the Office will place the amendment in the file for consideration at the time of examination of the statement of use. 37 C.F.R. §2.77. The ITU paralegal or legal instruments examiner will advise the applicant that the amendment has been received but that it will not be considered until the examining attorney examines the statement of use.

The applicant may file a petition under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment (other than an amendment deleting a basis or deleting specified goods/services) during the

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

period between the issuance of the notice of allowance and the filing of the statement of use. TMEP §1107.01. *In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm'r Pats. 1997). The petition must be accompanied by the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

The filing of an amendment after issuance of the notice of allowance does not extend the deadline for filing the statement of use. Unless the amendment requires republication, the applicant must file a statement of use or request for an extension of time to file a statement of use.

See TMEP §1106.04 regarding correction of errors in a notice of allowance, and TMEP §806.04(a) regarding the deletion of a §1(b) basis after issuance of a notice of allowance.

### **1107.01 Examination of Amendment Filed After the Notice of Allowance Issues But Before a Statement of Use is Filed [R-2]**

As noted in TMEP §1107, an applicant may file a petition under 37 C.F.R. §§2.146(a)(3) and (a)(5) to waive 37 C.F.R. §2.77 to permit an examining attorney to examine an amendment during the period between the issuance of a notice of allowance and the filing of a statement of use. *In re Upsher-Smith Laboratories, Inc.*, 45 USPQ2d 1371 (Comm'r Pats. 1997). If the applicant files such a petition and the petition is granted, the examining attorney will either accept or reject the proposed amendment(s) in accordance with the following procedures:

*Amendment Accepted/Republication Not Required:* If an examining attorney determines that the amendment is acceptable and republication is not required, the examining attorney will call the applicant to notify the applicant of acceptance. A notation is made in the file that the proposed amendment has been accepted and that the applicant has been notified of the acceptance of the amendment. The legal instruments examiner in the law office will enter the amendment and return the file to the ITU/Divisional Unit to await filing of a statement of use or extension request.

*Amendment Unacceptable:* If an examining attorney determines that the amendment is unacceptable, the examining attorney will call the applicant to notify the applicant that the amendment is denied. A notation is made in the file that the proposed amendment has been denied and that the applicant has been notified of this. The examining attorney will return the file to the ITU/Divisional Unit to await filing of a statement of use or extension request. The applicant must accept the denial, but may again request to amend the application when filing the statement of use. *Upsher-Smith*, 45 USPQ2d at 1374.

*Amendment Accepted; Republication Required:* If an examining attorney determines that the amendment is acceptable, but that republication is required, the examining attorney will call the applicant

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will make a notation in the file that the proposed amendment has been accepted, that republication is required, and that the applicant has been advised of this. The examining attorney will forward the file to the ITU/Divisional Unit for cancellation of the notice of allowance. The ITU/Divisional Unit will cancel the notice of allowance and send the file to the Photocomposition Coordinator in the Publication and Issue Section of the Office for text editing of the amendment and processing for republication.

*Examiner's Amendment Required; Republication Not Required:* If an examining attorney determines that an examiner's amendment is necessary, and republication is not required, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment will contain a statement that republication is not required. The examining attorney will forward the application file to the Photocomposition Coordinator in the Publication and Issue Section for text editing and mailing of the examiner's amendment. The Photocomposition Coordinator will then return the file to the ITU/Divisional Unit to await filing of a statement of use or extension request.

*Examiner's Amendment Required; Republication Required:* If an examining attorney determines that an examiner's amendment is necessary, and republication is required, the examining attorney will call the applicant to ask if the applicant wishes to maintain the request for amendment in light of the fact that republication is required. If the applicant elects to maintain the request, the examining attorney will prepare, but not mail, the examiner's amendment. The examiner's amendment will contain a statement that republication is required. The examining attorney will forward the file, with the unmailed examiner's amendment to the ITU/Divisional Unit for cancellation of the notice of allowance. The ITU/Divisional Unit will cancel the notice of allowance and send the file to the Photocomposition Coordinator in the Publication and Issue Section for text editing and mailing of the examiner's amendment and processing for republication.

*The granting of a petition to examine an amendment between issuance of the notice of allowance and filing of the statement of use does not extend the deadline for filing a statement of use (unless the notice of allowance is cancelled because the examining attorney determines that the amendment requires republication). Where an applicant has not yet received a response to a proposed amendment, the applicant must file its extension request or statement of use. The extension request or statement of use may use alternative language, e.g., refer both to the goods/services identified in the Notice of Allowance, and to a proposed amended identification.*

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### 1108 Requests for Extensions of Time to File the Statement of Use

Section 1(d) of the Trademark Act, 15 U.S.C. §1051(d), requires that a statement of use be filed within six months after the issuance of the notice of allowance, or before the expiration of a previously granted extension of time to file a statement of use. If the mark is not in use in commerce before the expiration of the six-month period following the issuance of the notice of allowance, the applicant must file a request for extension of time to file a statement of use within the six-month period to avoid abandonment of the application.

The first six-month extension can be requested without a showing of good cause. Up to four additional six-month extensions can be requested. These must include a showing of good cause. 15 U.S.C. §1051(d)(2). Thus, the time available for filing the statement of use may not be extended beyond thirty-six months from the mailing date of the notice of allowance.

**To expedite processing**, the Office prefers that an applicant file the extension request electronically, using the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov>. Alternatively, an applicant can call the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199 to obtain a pre-printed form. The applicant may mail, fax or hand-deliver the completed form to the Office. If the extension request is faxed or filed electronically, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account.

Extension requests filed on paper are handled by the ITU/Divisional Unit of the Office, and extension requests filed electronically through TEAS are handled by the legal instruments examiner in an e-commerce law office.

#### 1108.01 Time for Filing Requests for Extensions of Time to File the Statement of Use [R-1]

Under 15 U.S.C. §1051(d), the applicant must file the extension request within six months of the mailing date of the notice of allowance, or before the expiration of a previously granted extension; otherwise the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §§2.65(c) and 2.88(h).

Extensions of time are granted in six-month increments. 37 C.F.R. §2.89(c). The first extension will begin to run from the expiration of the six-month period following issuance of the notice of allowance. An applicant will receive the full benefit of each extension before a subsequent extension will begin to run. The six-month period following issuance of the notice of allowance (or any subsequent six-month extension period) will not be cut short by the grant of an extension. No extension will be granted for more than six months. 37 C.F.R. §2.89(b).

The applicant cannot file two extension requests within the same six-month period following the issuance of the notice of allowance. For example, if the notice of allowance is issued May 6, 2002, and the applicant files the first extension request on July 2, 2002, the applicant may file the second extension request no earlier than

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

November 7, 2002 (the beginning of the second six-month period after issuance of the notice of allowance) and no later than May 6, 2003 (the expiration of the first extension of time to file a statement of use).

The Office will notify the applicant of the grant or denial of a request for an extension of time, and of the reasons for a denial. However, failure to notify the applicant of the grant or denial of an extension request before the expiration of the requested extension does not relieve the applicant of the responsibility of timely filing a statement of use or further extension request. 37 C.F.R. §2.89(g).

Under 37 C.F.R. §1.6(a)(4), an extension request filed electronically through TEAS is considered to have been filed on the date the Office receives the transmission, regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. When an extension request is filed electronically through TEAS, the Office immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission, which is evidence of filing should any question arise as to the filing date of the request. *See* TMEP §301 for more information about electronic filing.

A request for an extension of time to file a statement of use filed on paper is considered timely if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission under 37 C.F.R. §1.8(a)(1). *See* TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

### **1108.02 Requirements for Request For An Extension of Time to File a Statement of Use**

#### *First Extension Request*

The first request for an extension of time to file a statement of use must include: (1) a written request, before expiration of the six-month period following issuance of the notice of allowance; (2) the prescribed fee for each class of goods or services; and (3) a verified statement signed by the applicant that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(a).

#### *Second and Subsequent Extension Requests*

A second or subsequent extension request must be submitted before expiration of a previously granted extension of time and must include: (1) a written request; (2) the prescribed fee for each class of goods or services; (3) a verified statement signed by the applicant that the applicant has a continued bona fide intention to use the mark in commerce, specifying those goods/services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; *and* (4) a showing of good cause, as required by 37 C.F.R. §2.89(d). 37 C.F.R. §2.89(b). Extensions of time under 37 C.F.R. §2.89(b) (*i.e.*,

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

second and subsequent extension requests) are granted in six-month increments and may not aggregate more than 24 months. 37 C.F.R. §2.89(c).

### **1108.02(a) Ownership**

The party filing the request for an extension of time to file a statement of use must be the owner of the mark at the time of filing. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). If the party filing the extension request is not the owner of record, the request should include the reel and frame number of any assignment (or other document of title) recorded in the Assignment Services Division of the Office, or other evidence that the party filing the extension request is the owner of the application in accordance with 37 C.F.R. §§3.71 and 3.73. (*Note:* An application under §1(b) cannot be assigned before the applicant files an allegation of use, except to a successor to the applicant's business, or portion of the business to which the mark pertains. *See* TMEP §501.01(a).)

If the extension request does not include the necessary evidence, the ITU paralegal or legal instruments examiner will issue an Office action denying the request. If the party who filed the extension request was the owner of the mark at the time of filing, the applicant may submit evidence to establish the chain of title after expiration of the statutory filing period. The response must be filed within the time provided in the Office action advising the applicant of the denial.

To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Division, and notify the Trademark Operation that the document has been recorded, specifying the reel and frame number at which the document is recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title has occurred. 37 C.F.R. §3.73(b)(1); TMEP §502.

If the applicant wants the registration to issue in the name of the new owner, the applicant must record a document with the Assignment Services Division *and* notify the Trademark Operation that the document has been recorded. 37 C.F.R. §3.85; TMEP §502.01. If the applicant notifies the ITU/Divisional Unit during the processing of an extension request that a document has been recorded, the ITU paralegal or legal instruments examiner will change the owner of record in TRAM.

If the party who filed the extension request was not the owner at the time of filing, the true owner may not file a substitute extension request unless there is time remaining in the statutory filing period. *Cf. In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994).

### **1108.02(b) Verification**

The extension request must be verified by someone properly authorized to sign on behalf of applicant. If the extension request is unsigned (or signed by the wrong

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

party), a substitute verification must be submitted before the expiration of the deadline for filing the statement of use. 37 C.F.R. §§2.89(a)(3) and 2.89(b)(3). *See* 37 C.F.R. §2.33(a) and TMEP §804.04 regarding the definition of a person properly authorized to sign on behalf of applicant. Generally, the Office will not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory's authority to sign.

If the extension request is not filed within one year after it is signed, the Office will require a substitute verification or declaration under 37 C.F.R. §2.20 that the applicant still has a bona fide intention to use the mark in commerce. 37 C.F.R. §2.89(h). *See* TMEP §804.03.

*See* TMEP §§301 and 804.05 regarding signature of electronically filed documents.

### **1108.02(c) Filing Fee**

A filing fee sufficient to cover at least one class must be submitted within the statutory time for filing the extension request, or the request will be denied. *See* 37 C.F.R. §§2.89(a)(2) and 2.89(b)(2). In a multiple-class application, if at least one complete fee is filed, the extension request will be provisionally accepted, and the ITU paralegal or legal instruments examiner will issue a notice of fee deficiency allowing the applicant additional time to remit the amount by which the fee was deficient. *In re Wolf*, 33 USPQ2d 1054 (Comm'r Pats. 1993). If the Office does not receive a timely response to a fee deficiency letter, the Office will apply the fees paid to the lowest numbered classes in ascending order, unless the applicant has expressly abandoned a specific unpaid-for class, and will delete the goods in the higher classes from the application.

If the filing fee for at least a single class is not submitted or is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, if an authorization to charge the fee to a credit card is refused or charged back by a financial institution, or if the check submitted as payment of the filing fee is returned unpaid), the fee for at least one class of goods or services must be submitted before the expiration of the statutory filing period. If the extension request was not accompanied by an authorization to charge deficient fees to a deposit account that has sufficient funds to cover the fee (37 C.F.R. §1.25), and the fee is not resubmitted before expiration of the statutory deadline, the extension request will be denied and the application will be abandoned. 37 C.F.R. §§2.89(a)(2) and (b)(2). In addition, when a fee charged to a credit card is refused or a check is returned unpaid, the applicant must pay the processing fee required by 37 C.F.R. §1.21(m).

*See* TMEP §405.01(a) regarding credit card charges that are refused or charged back, §405.02(a) regarding returned checks, and TMEP §405.03 regarding deposit accounts.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### **1108.02(d) Identification of Goods or Services**

The goods/services on or in connection with which the applicant still has a bona fide intention to use the mark in commerce must be identified in an extension request. 15 U.S.C. §1051(d)(2); 37 C.F.R. §§2.89(a)(3) and (b)(3). The goods/services identified in the extension request must conform to those identified in the notice of allowance. 37 C.F.R. §2.89(f). If goods or services are to be deleted, the applicant should clearly specify those goods and services to be deleted.

The applicant may incorporate by reference the specification of goods/services in the notice of allowance. This is advisable, in order to avoid the possibility that goods or services will be deleted unintentionally. Thus, the applicant may specify the goods/services by stating “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except..., [followed by a listing of the goods/services to be deleted].”

If the applicant lists the goods/services specifically in the request for an extension of time, and omits any goods or services that were listed in the notice of allowance, the Office will presume these goods/services to be deleted. The applicant may not thereafter request that the goods/services be reinserted in the application. 37 C.F.R. §2.89(f).

If an applicant files an extension request on a form provided by the Office and fails to check either of the boxes available for identifying the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce, the ITU paralegal or legal instruments examiner will assume that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with all the goods or services identified in the notice of allowance, and will grant the extension request, if it meets all other requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89. *In re Omega-3 Marketing Inc.*, 35 USPQ2d 1158 (Comm’r Pats. 1994).

*See* TMEP §1107 regarding amendments to the identification of goods/services filed between the issuance of the notice of allowance and the filing date of the statement of use.

### **1108.02(e) Bona Fide Intention to Use the Mark in Commerce**

A request for an extension of time to file a statement of use must include a verified statement that the applicant has a continued bona fide intention to use the mark in commerce on or in connection with the goods/services identified in the notice of allowance. 37 C.F.R. §§2.89(a)(3) and (b)(3). This is a statutory requirement that must be satisfied before expiration of the statutory period for filing the extension request. *In re Custom Technologies Inc.*, 24 USPQ2d 1712 (Comm’r Pats. 1991); *In re Raychem Corp.*, 20 USPQ2d 1355 (Comm’r Pats. 1991).

The Office will accept an allegation of actual use in commerce as meeting the requirement for an allegation of bona fide intention to use the mark in commerce in

an extension request. *In re Vitamin Beverage Corp.*, 37 USPQ2d 1537 (Comm'r Pats. 1995).

See TMEP §1101 for additional information about the requirement for an allegation of the applicant's bona fide intention to use the mark in commerce.

**1108.02(f) Good Cause Required for Extensions Beyond the First Six-Month Extension**

No showing of good cause is required in the first request for an extension of time to file a statement of use. However, each subsequent extension request must include a showing of good cause. 15 U.S.C. §1051(d)(2); 37 C.F.R. §2.89(b)(4). The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods/services covered by the extension request. Efforts to use the mark in commerce may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts may be submitted. 37 C.F.R. §2.89(d).

A mere assertion that the applicant is engaged in ongoing efforts is not enough; the efforts must be specified. *In re Comdial Corp.*, 32 USPQ2d 1863 (Comm'r Pats. 1993). However, the Office will not require a detailed explanation or evidence in a showing of good cause. The statement concerning good cause only has to refer to the types of activities listed in the rule or similar types of activities. For example, the applicant may simply state that the applicant is engaged in manufacturing and promotional activities.

The applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, and is in the process of preparing (or is concurrently filing) a statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time to file a new statement of use. However, such a statement will be accepted only once as a statement of the applicant's ongoing efforts to make use the mark in commerce. Repetition of these same allegations in a subsequent extension request is not, without more, deemed to be a statement of the applicant's *ongoing* efforts, as required by 37 C.F.R. §2.89(d). *In re SPARC International Inc.*, 33 USPQ2d 1479 (Comm'r Pats. 1993).

If an extension request does not include a showing of good cause, or if the showing of good cause in an extension request is deemed insufficient, the ITU paralegal or legal instruments examiner will issue an Office action denying the extension request but granting the applicant additional time to overcome the denial by submitting a verified showing of good cause (or a substitute extension request that includes a showing of good cause). *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220 (Comm'r Pats. 1996).

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### 1108.03            **Only One Extension Request May Be Filed With or After a Statement of Use**

An applicant may file a request for an extension of time to file a statement of use with a statement of use, or after filing the statement of use if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use more than thirty-six months after the issuance of the notice of allowance. *The applicant may not request any further extensions of time after this request.* 37 C.F.R. §2.89(e)(1).

The purpose of such a request (sometimes called an “insurance” extension request) is to secure additional time to correct any deficiency in the statement of use that must be corrected before the expiration of the deadline for filing the statement of use. *See* TMEP §§1109.01 and 1109.16(a) regarding the deficiencies that must be cured before expiration of the statutory filing period. Consider the following examples:

*Example:* If the notice of allowance were issued February 6, 2002, and the applicant filed the statement of use on August 6, 2002 (but did not file an extension request), the applicant has only until August 6, 2002 to cure any deficiency that must be corrected before the expiration of the statutory period for filing the statement of use.

*Example:* If the notice of allowance were issued February 6, 2002, the applicant could file a statement of use, together with an “insurance” request for an extension of time to file a statement of use, on or before August 6, 2002. If the extension request were granted, this would give the applicant until February 6, 2003 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.

*Example:* If the notice of allowance were issued February 6, 2002, and the applicant filed a statement of use on February 7, 2002, the applicant could file an “insurance” extension request on or before August 6, 2002. If the request were granted, this would give the applicant until February 6, 2003 to cure any deficiency that must be corrected before the expiration of the statutory filing period. No further extension request(s) could be filed.

An extension request filed with a statement of use (or after the filing of the statement of use) must meet all relevant requirements including payment of the applicable fee. If the request is not the first request for an extension of time, and thus a showing of good cause is required, the applicant may satisfy the requirement for a showing of good cause by asserting that the applicant believes that it has made valid use of the mark in commerce, as evidenced by the statement of use, but that if the statement of use is found to be fatally defective, the applicant will need additional time to correct defects or file a substitute statement of use. 37 C.F.R. §2.89(e)(2); TMEP §1108.02(f).

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

The filing fee for the “insurance” extension request will not be refunded, even if the extension is not needed to perfect the statement of use.

If the applicant files an insurance extension request in conjunction with a statement of use, and the applicant submits fees sufficient for one but not both, the Office will apply the fees as follows: (1) if there is enough money to cover the extension request, the Office will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the Office will apply the fees to the statement of use. *See* TMEP §1110.04 regarding the application of fees when an applicant submits a request to divide along with an extension request and statement of use.

If an applicant files an extension request with a statement of use and the extension request is defective, the ITU paralegal or legal instruments examiner will deny the request and will advise the applicant of the reason for denial. The paralegal or legal instruments examiner will then forward the file to the examining attorney if the statement of use meets the minimum requirements for examination on the merits. If there is time remaining in the current period for filing a statement of use, the applicant may file a substitute extension request.

*See* TMEP §1108.03(a) regarding the processing of an extension request after a statement of use has been referred to an examining attorney.

### **1108.03(a) Processing Extension Request Filed After Statement of Use Has Been Referred to Examining Attorney**

Under 37 C.F.R. §2.89(e)(1), an applicant may file a request for an extension of time to file a statement of use after filing a statement of use if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use more than thirty-six months after the issuance of the notice of allowance. *See* TMEP §1108.03.

When an extension request is filed after the statement of use has been referred to the examining attorney, the request will be routed to the examining attorney and associated with the file. The Office will not examine the extension request unless the applicant needs the extension to perfect the statement of use.

If the examining attorney issues a requirement or refusal based on the statement of use, the examining attorney should note in the Office action that the extension request is being forwarded to the ITU Unit (or legal instruments examiner in an e-commerce law office) for processing of the extension request, and then forward the file. If the examining attorney does not issue a requirement or refusal based on the statement of use, the Office will not take formal action on the extension request.

The Office will not refund the filing fee for the extension request, even if the extension is not needed to perfect the statement of use.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

Filing an extension request does *not* extend the time for responding to an examining attorney's Office action. *See* TMEP §1109.16(d).

### **1108.04 Recourse After Denial of Extension Request**

If an extension request is denied, the applicant will be notified of the reason(s) for denial.

To avoid abandonment of the application, the applicant must meet the minimum requirements for filing the extension request on or before the deadline for filing a statement of use.

If the Office denies the extension request because the applicant failed to meet minimum filing requirements on or before the statutory deadline, and there is time remaining in the applicant's existing period for filing the statement of use, the applicant may file the statement of use and/or a substitute extension request. Otherwise, the applicant's only recourse after denial of the extension request is a petition under 37 C.F.R. §§2.89(g) and 2.146, or a petition to revive under 37 C.F.R. §2.66, if appropriate. *See* TMEP §1108.05 regarding petitions that can be filed after the denial of an extension request.

The minimum filing requirements that must be satisfied before expiration of the statutory deadline are: (1) a verified statement that the applicant has a continued bona fide intention to use the mark in commerce; (2) a specification of the goods/services on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce; and (3) payment of the prescribed fee for at least one class of goods or services. *In re El Taurino Restaurant, Inc.*, 41 USPQ2d 1220, 1222 (Comm'r Pats. 1996).

### **1108.05 Petitions From Denial of Request For An Extension of Time to File Statement of Use**

If an extension is denied, and there is no time remaining in the statutory filing period, applicant's recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements (see TMEP §1108.04 for a list of the minimum filing requirements), the applicant may file a petition to revive under 37 C.F.R. §2.66, within two months of the mailing date of the denial of the extension request. *See* TMEP §§1714 et seq. regarding petitions to revive.
- *Request for Reinstatement.* If the applicant has proof that shows on its face that the extension request met the minimum requirements when filed, the applicant may request reinstatement within two months of the mailing date of the denial of the extension request. For example, if the extension request is denied due to the omission of a fee, and the applicant has proof that shows on

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

its face that the fee was included (such as a cancelled check or a stamped postcard that specifically references the fee), the applicant may request reinstatement. No fee is required. The request should be directed to the ITU Unit. See TMEP §1712.01 regarding the types of evidence that support reinstatement.

- *Petition Under 37 C.F.R. §2.146.* If the applicant contends that the extension request met the minimum requirements when filed, but the applicant does *not* have proof that shows *on its face* that the request was complete when filed (see TMEP §1712.01), the applicant must file a formal petition under 37 C.F.R. §2.146(a)(3), within two months of the mailing date of the denial of the extension request. The petition must include the fee required by 37 C.F.R. §2.6, a copy of the papers filed, proof in the form of an affidavit or declaration under 37 C.F.R. §2.20, and any available evidence showing that the extension request was complete when filed. See TMEP §1705.03 regarding proof of facts on petition. For example, if the extension request is denied due to the omission of a fee, and the applicant declares that the extension request was accompanied by a check, but the applicant does not have proof that shows *on its face* that the fee was included, the applicant may file a petition requesting the Director to exercise supervisory under 37 C.F.R. §2.146(a)(3) to determine that the extension request met minimum requirements on the filing date.

A petition under 37 C.F.R. §2.146 may also be appropriate when the applicant believes that the ITU paralegal's denial of an extension request was improper (e.g., if applicant contends that the extension request actually met the requirements of 15 U.S.C. §1051(d)(2) and 37 C.F.R. §2.89, but was improperly denied). 37 C.F.R. §§2.89(g) and 2.146(a)(2). For example, the applicant might file a petition claiming that the denial was improper if the paralegal denied an extension request because the applicant's showing of good cause was insufficient, but applicant believes that the showing was sufficient. The applicant must file the petition within two months of the mailing date of the denial of the extension request, and must include the fee required by 37 C.F.R. §2.6. See TMEP Chapter 1700 regarding petitions.

Filing a petition or request for reinstatement does not stay the time for filing a statement of use or further extension request. 37 C.F.R. §2.89(g). However, if the applicant fails to file a statement of use or further request(s) for extension(s) of time to file a statement of use during the pendency of a petition, the applicant will be given an opportunity to perfect the petition by paying the fees for each missed extension request and filing the last extension request, or statement of use, that should have been filed. *In re Moisture Jamzz, Inc.*, 47 USPQ2d 1762 (Comm'r Pats. 1997).

If a petition is granted, the term of the requested six-month extension will run from the date of the expiration of the previously existing six-month period for filing a statement of use. 37 C.F.R. §2.89(g).

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

### **1109 Statement of Use Under §1(d) of the Trademark Act**

As noted in TMEP §1103, an intent-to-use applicant must file either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) to obtain a registration. This section discusses statements of use only. *See* TMEP §§1104 *et seq.* regarding amendments to allege use.

Under 15 U.S.C. §1051(d), a statement of use must be filed within six months of the mailing date of the notice of allowance, or within a previously granted extension of time.

#### **1109.01 Minimum Filing Requirements for a Statement of Use**

The minimum requirements that a statement of use must meet before it can be referred to an examining attorney for examination on the merits are:

- (1) the prescribed fee for at least one class;
- (2) one specimen or facsimile of the mark as used in commerce; and
- (3) a verification or declaration signed by the applicant stating that the mark is in use in commerce.

37 C.F.R. §2.88(e).

A statement of use that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, may be accepted as substantially in compliance with the minimum filing requirement of 37 C.F.R. §2.88(e)(3) for a verified statement that the mark is in use in commerce. *In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm’r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm’r Pats. 1992). The examining attorney will require an allegation that the “mark is in use in commerce” during examination. *See* TMEP §1109.09.

*See* TMEP §1109.02 regarding review of the statement of use for compliance with minimum filing requirements, and TMEP §1109.06 regarding the necessary elements in a complete statement of use.

#### **1109.02 Review for Compliance with Minimum Filing Requirements**

Statements of use filed on paper are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum requirements listed in 37 C.F.R. §2.88(e). Statements of use filed electronically through TEAS are reviewed for timeliness and compliance with minimum filing requirements by the legal instruments examiner in an e-commerce law office. If the statement of use is

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

untimely, either because it is premature or late, the ITU paralegal or legal instruments examiner will notify the applicant that the statement of use cannot be considered because it is late, and refund the filing fee.

If the statement of use is timely, but does not comply with one or more of the minimum filing requirements of 37 C.F.R. §2.88(e), the ITU paralegal or legal instruments examiner will notify the applicant of the defect and will advise the applicant that the Office will not examine the statement of use on the merits unless the applicant can correct the defect before expiration of the deadline for filing a statement of use.

If the applicant does not correct the deficiency before the expiration of the statutory deadline, the application will be declared abandoned. In such a case, the Office will *not* refund the filing fee.

The paralegal or legal instruments examiner will review the verification or declaration stating that the mark is in use in commerce to determine whether it bears a signature, but will not question the authority of the person who signed. *See* TMEP §1109.11(a) regarding the proper party to sign on behalf of applicant.

The ITU paralegal or legal instruments examiner will not determine whether the statement of use was filed by the record owner of the application. That issue will be addressed by the examining attorney. *See* TMEP §1109.10.

The applicant may not withdraw the statement of use and return the application to the previous status of awaiting filing of the statement of use, even if the statement of use fails to meet the minimum filing requirements. 37 C.F.R. §2.88(g); TMEP §1109.17.

However, to gain additional time to comply with the minimum requirements, the applicant may file a final (“insurance”) extension request with or after the filing of a statement of use, if there is time remaining in the statutory period for filing the statement of use, provided that granting the extension request would not extend the time for filing the statement of use beyond thirty-six months from the issuance of the notice of allowance. 37 C.F.R. §2.89(e)(1); TMEP §1108.03.

### **1109.02(a) Petition to Review Refusal Based on Noncompliance with Minimum Filing Requirements of 37 C.F.R. §2.88(e)**

If the ITU paralegal or legal instruments examiner determines that a statement of use does not meet the minimum requirements of 37 C.F.R. §2.88(e), and there is no time remaining in the statutory filing period, applicant’s recourse is as follows:

- *Petition to Revive Under 37 C.F.R. §2.66.* If the applicant unintentionally failed to comply with the minimum filing requirements, the applicant may file a petition to revive under 37 C.F.R. §2.66 within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient. *See* TMEP §§1714 *et seq.* regarding petitions to revive.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

- *Request for Reinstatement.* If the applicant has *proof that shows on its face* that the statement of use met the minimum requirements when filed, the applicant may request reinstatement, within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient. For example, if the statement of use is rejected due to the omission of a specimen or fee, and the applicant has proof that shows on its face that the missing element was included (such as a stamped postcard specifically referencing the missing element), the applicant may request reinstatement. No fee is required. The request should be directed to the ITU Unit. *See* TMEP §1712.01 regarding the types of evidence that support reinstatement.
- *Petition Under 37 C.F.R. §2.146.* If the applicant contends that the statement of use met the requirements of 37 C.F.R. §2.88(e) when filed, but the applicant does *not* have proof that shows *on its face* that the statement of use was complete when filed (*see* TMEP §1712.01), the applicant must file a formal petition under 37 C.F.R. §2.146(a)(3), within two months of the mailing date of the Office action notifying the applicant that the statement of use is deficient. The petition must include the fee required by 37 C.F.R. §2.6, a copy of the papers filed, proof in the form of an affidavit or declaration under 37 C.F.R. §2.20, and any available evidence showing that the statement of use was complete when filed. *See* TMEP §1705.03 regarding proof of facts on petition. For example, if the statement of use is rejected due to the omission of a specimen, and the applicant declares that the statement of use was accompanied by a specimen, but the applicant does not have proof that shows *on its face* that the specimen was included, the applicant may file a petition requesting the Director to exercise supervisory under 37 C.F.R. §2.146(a)(3) to determine that the statement of use was complete on the filing date.

No petition or request for reinstatement will be granted if it would extend the deadline for filing a statement of use beyond thirty-six months after the issuance of the notice of allowance. 15 U.S.C. §1051(d)(2).

### **1109.03 Use on All Goods or Services Required Before Filing**

The applicant may not file a statement of use until the applicant has made use of the mark in commerce on or in connection with all goods/services specified in the notice of allowance, unless the applicant files a request to divide. 37 C.F.R. §2.88(c). *See* TMEP §§1110 *et seq.* regarding requests to divide.

If the applicant files a statement of use for some of the goods/services identified in the notice of allowance, and a request for an extension of time to file a statement of use for other goods/services that are identified in the notice of allowance, but does not file a request to divide, the ITU Unit will issue an Office action granting the applicant additional time to either: (1) file a request to divide, or (2) delete the goods/services that are not in use from the application. *See* TMEP §§1110 *et seq.* regarding requests to divide. If the applicant met the minimum requirements for filing the statement of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

use and extension request before expiration of the deadline for filing the statement of use, the applicant may file the request to divide after expiration of the statutory deadline for filing the statement of use. If the applicant does not file a proper request to divide within the time specified in the Office action, the goods/services that are not covered by the statement of use will be deleted from the application.

*See* TMEP §1109.13 regarding examination of a statement of use that omits, but does not expressly delete, some of the goods/services identified in the notice of allowance.

### **1109.04 Time for Filing Statement of Use [R-1]**

The statement of use must be filed within six months after the mailing date of the notice of allowance or within a previously granted extension of time for filing the statement of use. *See* TMEP §§1108 *et seq.* regarding extension requests.

Under 37 C.F.R. §1.6(a)(4), a statement of use filed electronically through TEAS is considered to have been filed on the date the Office receives the transmission, regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. When a statement of use is filed electronically through TEAS, the Office immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date. *See* TMEP §301 for more information about electronic filing.

A statement of use filed on paper is considered timely if it is mailed or transmitted by the due date with a certificate of mailing or facsimile transmission in accordance with 37 C.F.R. §1.8(a)(1). *See* TMEP §§305.02 and 306.05 for certificate of mailing and certificate of facsimile transmission procedures to avoid lateness.

Any statement of use filed after the examining attorney approves the mark for publication but before the notice of allowance is mailed is untimely and will not be considered. The Office will refund the filing fee for the untimely statement of use. 37 C.F.R. §§2.76(a) and 2.88(a); TMEP §1104.03(c).

If the applicant does not timely file a statement of use within six months after the mailing date of the notice of allowance (or before the expiration of a previously granted extension of time to file the statement of use), the application is abandoned. 15 U.S.C. §1051(d)(4); 37 C.F.R. §2.88(h). If the failure to timely file a statement of use is unintentional, the applicant may file a petition to revive under 37 C.F.R. §2.66. *See* TMEP §§1714 *et seq.*

If a paper captioned as a “statement of use” is filed before the examining attorney approves the mark for publication, the Office will process it as an amendment to allege use. *See* TMEP §§1104 *et seq.* regarding amendments to allege use.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### **1109.05 Form of Statement of Use**

To expedite processing, it is recommended that the statement of use be filed electronically using the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov>. See TMEP §301 for more information about electronic filing.

Alternatively, the applicant can call the Trademark Assistance Center at (703) 308-9000 or (800) 786-9199 to have a pre-printed form mailed. The completed form may be mailed, faxed, or hand-delivered to the Office. If the statement of use is filed electronically or a completed form is faxed to the Office, it must be accompanied by an authorization to charge the filing fee to a credit card or deposit account.

If the applicant does not file electronically or use the Office's form, the statement of use should be clearly titled "Statement of Use." 37 C.F.R. §2.88(d). The mailing address should specify "Box ITU" and include a "FEE" designation (*see* 37 C.F.R. §1.1(h); TMEP §305.01). However, this format is not mandatory. While proper identification of the statement of use will expedite handling, the Office will accept any statement of use that meets the requirements of 37 C.F.R. §2.88, regardless of whether it is properly titled or filed on the Office's form.

### **1109.05(a) Papers Prepared for Filing as an Amendment to Allege Use May Be Filed as a Statement of Use**

Papers that were prepared for filing as an amendment to allege use may be filed as a statement of use if the papers are filed at the appropriate time (*see* TMEP §1109.04) and meet the requirements of 37 C.F.R. §2.88. The applicant may amend the form, as necessary, to eliminate inappropriate language in referring to the goods/services. For example, the applicant can amend an identification referring to "the goods/services identified in the application" to "the goods/services identified in the notice of allowance."

If an applicant is filing a statement of use that was prepared for filing as an amendment to allege use, the applicant should ensure that the appropriate mailing address is used, as indicated in TMEP §305.01, and that it is clear that the paper is to be considered a statement of use. The applicant can provide a transmittal letter or cover sheet to clearly identify the paper as a statement of use.

If the statement of use is filed more than one year after the date of execution, the examining attorney will require a substitute verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.88(k); TMEP §804.03.

### **1109.06 Necessary Elements in a Complete Statement of Use**

*A complete* statement of use must include the following elements:

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (1) a verified statement that the applicant is believed to be the owner of the mark and that the mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce, and a listing of those goods or services specified in the notice of allowance on or in connection with which the mark is in use in commerce;
- (2) one specimen or facsimile per class of the mark as used in commerce; and
- (3) the fee per class required by 37 C.F.R. §2.6.

37 C.F.R. §2.88(b).

### **1109.07 Examination of the Statement of Use — In General**

If the statement of use is timely and complies with the minimum requirements of 37 C.F.R. §2.88(e), the ITU paralegal or legal instruments examiner will refer it to the examining attorney for examination on the merits. If available, the same examining attorney who initially examined the application will examine the statement of use. Examination of the statement of use is sometimes referred to as “second examination.”

The examining attorney will review the statement of use to confirm that it meets the requirements of the Act and the rules. *See* TMEP §1109.06 for the necessary elements in a complete statement of use.

The examining attorney will examine the specimen to confirm that it shows use as a mark on or in connection with the goods/services identified in the statement of use (*see* TMEP §§1202 *et seq.* and 1301.02 *et seq.*), and will also determine whether the mark shown on the drawing is a substantially exact representation of the mark as used on the specimens (*see* TMEP §§807.14 and 1109.12).

If the applicant has complied with the statutory requirements for a statement of use before the expiration of the deadline for filing the statement of use, the applicant may amend or otherwise correct the statement of use during examination. *See* TMEP §§1109.16(a) through 1109.16(d) regarding compliance with statutory requirements before the expiration of the time for filing the statement of use.

If the examining attorney finds the statement of use acceptable, the Office will notify the applicant that the statement of use is approved. *See* TMEP §1109.18 regarding approval of the statement of use. The Office will then issue the registration and publish notice of the registration in the *Official Gazette*. The application is not again subject to opposition.

### **1109.08 The “Clear-Error” Standard in Examination of the Statement of Use**

Generally, in examining the statement of use, the Office will only issue requirements or refusals concerning matters related to the statement of use. The Office will not

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

issue any requirements or refusals concerning matters that could or should have been raised during initial examination unless the failure to do so in initial examination constitutes a clear error. “Clear error” means an error that, if not corrected, would result in issuance of a registration in violation of the Act. The failure to make a refusal is a clear error if reasonable minds could not differ as to the propriety of the refusal.

The examining attorney must act on all new issues arising in the examination of the statement of use. For example, the examining attorney must issue an appropriate refusal if the specimen fails to show use of the designation as a mark. *See* TMEP §§1202 *et seq.* and 1301.02 *et seq.*

The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error. If a significant length of time has elapsed since the initial examination, in some cases, the mark may have become descriptive or even generic as applied to the goods or services. In such a case, the evidence of the descriptive or generic use would not have been available during initial examination, so the clear error standard would not apply.

However, if evidence that the mark is merely descriptive was available during initial examination and the refusal could or should have been issued in initial examination, the examining attorney may not issue the refusal unless there is clear error. That is, the evidence of descriptiveness must be substantial and unequivocal.

Likewise, the examining attorney must not issue requirements or refusals related to informalities that could or should have been addressed during the initial examination unless there is clear error.

If the goods or services were classified incorrectly and published for opposition in the wrong class, the examining attorney should require correction of the classification, because publication in the wrong class is a clear error. In the case of any change of international class after issuance of the notice of allowance, the mark must be republished for opposition.

If a disclaimer could or should have been required during initial examination, the examining attorney should not require a disclaimer during the examination of the statement of use unless there is clear error. For example, a disclaimer of all of the wording in a mark may be required under the clear-error standard when the mark consists of merely descriptive wording and distinctive design elements if the evidence of descriptiveness is substantial and unequivocal. Issuing a registration without the disclaimer would violate the Act by granting the applicant rights beyond those to which the applicant is entitled.

Generally, the Office will not conduct any search for conflicting marks or issue any refusals under §2(d) of the Act in the examination of the statement of use. However, if the examining attorney determines that a second search is necessary, the examining

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

attorney will conduct a second search and take any action that is appropriate. Sometimes, the Office may discover a clear error during internal Office quality review or through a letter of protest. The Office will not issue any refusal under §2(d) in the examination of the statement of use unless the failure to issue the refusal constitutes a clear error.

On appeal, the Trademark Trial and Appeal Board will review only the correctness of the underlying substantive refusal of registration. The Board will not second guess the application of the “clear error” standard. The question of whether the examining attorney properly applied the “clear error” standard is reviewable on petition under 37 C.F.R. §2.146. *In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997). See TMEP Chapter 1700 regarding petitions.

### **1109.09 Use in Commerce**

The filing of a verified statement that “the mark is in use in commerce” is a minimum requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3). If the examining attorney determines, before taking an action in connection with the statement of use, that the verified statement of use in commerce has been omitted, the examining attorney should return the file to the ITU Unit (or the legal instruments examiner in an e-commerce law office) for appropriate action.

An application that omits the allegation of use in commerce, but asserts a verified date of first use in commerce, is considered to be substantially in compliance with the minimum filing requirements under 37 C.F.R. §2.88(e)(3). *In re Carnicon Development Company*, 34 USPQ2d 1541 (Comm’r Pats. 1992); *In re Conservation Technology Inc.*, 25 USPQ2d 1079 (Comm’r Pats. 1992). Thus, if the applicant files a statement containing a verified date of first use *in commerce* on or before the expiration of the period for filing the statement of use, the applicant has met minimum filing requirements. The examining attorney must nevertheless require a verified statement that the “mark is in use in commerce.” This statement may be filed after expiration of the deadline for filing the statement of use, within the period for response to the examining attorney’s Office action.

An applicant is not required to specify the method of use or the type of commerce in which a mark is used. TMEP §§903.03 and 905.

### **1109.09(a) Dates of Use**

The statement of use must include the dates of the applicant’s first use of the mark and first use of the mark in commerce. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1)(ii). However, this is not a minimum filing requirement that must be met before the application will be referred to the examining attorney. If the dates of use are omitted from the statement of use, but the statement that “the mark is in use in commerce” is included, the dates can be supplied after the expiration of the statutory period for filing the statement of use. The applicant may also amend or correct the

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

dates of use after the expiration of the deadline for filing the statement of use, if the applicant meets the requirements of 37 C.F.R. §2.71(c)(2). Any amendment to the dates of use must be verified. 37 C.F.R. §2.71(c).

The date of first use in commerce may not be earlier than the date of first use anywhere. TMEP §903.04. The applicant must state dates of use for each class. The dates of first use for each class must apply to at least one item in the class but do not have to apply to more than one item. However, the applicant must have used the mark in commerce on all items listed in the notice of allowance before filing the statement of use, unless the applicant files a request to divide. TMEP §1109.03. *See* TMEP §§1110 *et seq.* regarding requests to divide.

The dates of use can be supplied after expiration of the statutory filing period; however, the applicant must make valid use of the mark in commerce on or in connection with all the goods/services in the application before the expiration of the time for filing the statement of use. 37 C.F.R. §2.71(c)(2). If the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. When refusing registration on this ground, the examining attorney should issue a regular Office action with a six-month response clause. *See* TMEP §1109.16(b).

### **1109.09(b)        Specimens**

The examining attorney must examine the specimen(s) to confirm that they show use of the subject matter as a mark on or in connection with the goods/services identified in the statement of use. *See* TMEP §§1202 and 1301.02 *et seq.* The examining attorney must also determine whether the mark as used on the specimens is a substantially exact representation of the mark on the drawing (*see* TMEP §§ 807.14 and 1109.12). The examining attorney should issue requirements and refusals, as appropriate, based on the examination of the specimens, subject to the same standards that govern the examination of specimens in initial examination. TMEP §§904 *et seq.*

The submission of at least one specimen with a statement of use is a statutory requirement that must be satisfied before expiration of the statutory period for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e); *In re Campbell*, 33 USPQ2d 1055 (Comm'r Pats. 1993). If the examining attorney determines, before taking an action regarding the statement of use, that no specimen has been submitted, the examining attorney should return the file to the ITU Unit (or the legal instruments examiner in an e-commerce law office) for appropriate action.

In a multi-class application, the applicant must submit one specimen for each class of goods/services in the statement of use before the statement of use can be approved. 37 C.F.R. §§2.86(b) and 2.88(b)(2). However, only one specimen for one class is needed to comply with the minimum filing requirements. If at least one specimen is filed within the time permitted for filing the statement of use, specimen(s) for the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

other class(es) can be filed after the expiration of the statutory filing period, if the applicant verifies that the additional specimen(s) was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b).

If the applicant files at least one specimen with the statement of use, but the specimen is unacceptable, the applicant may provide a substitute specimen after the expiration of the time permitted for filing the statement of use, provided that the applicant verifies that the substitute specimen was in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. The examining attorney should issue a regular Office action with a six-month response clause. TMEP §1109.16(b). *See* TMEP §1108.03 regarding the filing of an “insurance” request for an extension of time to file a statement of use in order to gain additional time to make proper use of the mark.

If the dates of first use change as a result of the submission of a new specimen, the applicant must also amend the dates of use in the statement of use. The amendment must be supported by an affidavit or declaration. 37 C.F.R. §2.71(c); TMEP §1109.09(a).

If the statement of use is filed electronically using TEAS, the applicant must submit a digitized image (*e.g.*, .gif or .jpg) file so the Office can generate a copy of the specimen. 37 C.F.R. §2.56(d)(4). *See* TMEP §904.02 for additional information about electronically filed specimens.

### **1109.10            Ownership**

The party filing the statement of use must be the owner of the mark at the time the statement is filed. If the party filing the statement of use is the owner at the time of filing but the records of the Office show title in another party, the examining attorney must require the applicant to submit evidence to establish chain of title. If the party who filed the statement of use was the owner at the time of filing, evidence to establish ownership can be provided after expiration of the deadline for filing the statement of use. *See* 37 C.F.R. §§3.71 and 3.73; TMEP §502. To establish ownership, the new owner must either: (1) record an assignment or other document of title with the Assignment Services Division, and notify the Trademark Operation that the document has been recorded, specifying the reel and frame number at which the document is recorded; or (2) submit other evidence of ownership, in the form of a document transferring ownership from one party to another or an explanation, in the form of an affidavit or declaration under 37 C.F.R. §2.20, that a valid transfer of legal title occurred prior to filing the statement of use. 37 C.F.R. §3.73(b)(1); TMEP §502. The applicant must submit the evidence within the response period specified in the examining attorney’s Office action.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

If the applicant wants the registration to issue in the name of the new owner, the applicant must record a document with the Assignment Services Division *and* notify the Trademark Operation that the document has been recorded. 37 C.F.R. §3.85; TMEP §502.01. If an assignment has been recorded, the examining attorney should instruct the legal instruments examiner to update the ownership information in TRAM. *See also* TMEP §502.01(a) regarding an examining attorney's handling of an application after the mark has been assigned.

If the party who filed the statement of use was not the owner of the mark at the time of filing, the true owner may not file a substitute statement of use unless there is time remaining in the statutory filing period. *In re Colombo Inc.*, 33 USPQ2d 1530 (Comm'r Pats. 1994). *See* TMEP §1108.03 regarding the filing of an "insurance" request for extension of time to file a statement of use in order to gain additional time to file a proper statement of use.

Therefore, if the party filing the statement of use is not the owner of the mark at the time the statement of use is filed, the examining attorney cannot accept the statement of use. If no time remains in the statutory period for filing the statement of use, the examining attorney must refuse registration because no acceptable statement of use was filed within the time permitted, and hold the application abandoned. A regular Office action refusing registration should be issued, with a six-month response period. *See* TMEP §1109.16(b).

### **1109.11 Verification and Execution**

The requirement that a statement of use include a signed verification or declaration is a statutory requirement that must be satisfied before expiration of the deadline for filing the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(e)(3); *In re Kinsman*, 33 USPQ2d 1057 (Comm'r Pats. 1993).

If, before taking an action in connection with the statement of use, the examining attorney determines that the statement of use does not include a signed verification or declaration, the examining attorney should return the file to the ITU Unit (or the legal instruments examiner in an e-commerce law office) for appropriate action.

#### **1109.11(a) Authority of Signatory**

A statement of use must include a statement that is signed and verified by a person properly authorized to sign on behalf of the applicant. 37 C.F.R. §2.88(b)(1). Anyone who can verify the initial application can verify the statement of use. Generally, the Office will not question the authority of the person who signs a verification unless there is an inconsistency in the record as to the signatory's authority to sign. *See* TMEP §804.04.

**1109.11(b) Verification of Essential Elements**

The examining attorney must review the verified statement of use to confirm that it conforms to the requirements of the Act and the rules. The statement must include a verified statement that the applicant believes it is the owner of the mark, and a verification of the dates of use and identification of the goods/services. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1). *See* TMEP §1109.10 regarding ownership, TMEP §1109.09(a) regarding dates of use, and TMEP §1109.13 regarding the identification of goods/services.

The averment of ownership is an essential element of the verification. If it is omitted, the examining attorney must require the applicant to submit a verified statement that the applicant is the owner of the mark. This statement can be submitted after expiration of the time for filing the statement of use.

**1109.11(c) Date of Execution**

If the statement of use was executed before the stated dates of use, the examining attorney must require that the statement be re-executed. *See* TMEP §903.07(a) regarding apparent discrepancies between dates of use and execution dates, and TMEP §§903.05 and 1109.09(a) regarding amendment of the dates of use.

If the statement of use is filed more than one year after the date of execution, the examining attorney will require a substitute verification or declaration under 37 C.F.R. §2.20 stating that the mark is still in use in commerce. 37 C.F.R. §2.88(k); TMEP §804.03.

**1109.11(d) Signature of Electronically Transmitted Statement of Use**

*See* TMEP §§301 and 804.05 regarding signature of electronically filed documents.

**1109.12 Drawing**

Under 37 C.F.R. §2.51(a)(2), the drawing in an intent-to-use application must be a substantially exact representation of the mark as intended to be used *and* as actually used on filing the amendment to allege use or statement of use. An applicant may not amend the mark in a drawing if the amendment is a material alteration of the mark on the original drawing submitted with the application. 37 C.F.R. §2.72(b)(2); TMEP §807.14(a). Also, the mark in the drawing must agree with the mark as used on the specimen(s). TMEP §807.14. The same standards for determining whether a specimen supports use of the mark and whether an amendment can be permitted that apply to use based applications also apply in the examination of the statement of use. *See* TMEP §§807.14 *et seq.*

Therefore, if the mark in the drawing filed with the application is not a substantially exact representation of the mark as used on the specimen filed with the statement of use, the examining attorney must require: (1) *either* submission of a new specimen *or*

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

an amendment of the mark in the drawing, if the amendment of the mark would not be a material alteration of the mark on the original drawing; or (2) submission of a new specimen, if the amendment of the mark would be a material alteration of the mark on the original drawing. 37 C.F.R. §2.72(b)(2). *See* TMEP §807.14(a) regarding material alteration.

### **1109.13 Identification of Goods and Services in Statement of Use**

The statement of use must either list or incorporate by reference the goods/services specified in the notice of allowance on or in connection with which the mark is in use in commerce. 15 U.S.C. §1051(d)(1); 37 C.F.R. §2.88(b)(1)(ii). The goods/services specified in the statement of use must conform to the goods/services identified in the notice of allowance. 37 C.F.R. §2.88(i)(1). To incorporate the goods/services by reference, the applicant may state that the mark is in use on “those goods/services identified in the notice of allowance” or “those goods/services identified in the notice of allowance except...[followed by an identification of the goods/services to be deleted].”

If the applicant omits any goods/services specified in the notice of allowance from the identification of goods/services in the statement of use, and the applicant has not expressed a clear intention to delete those goods/services, the examining attorney must inquire as to the discrepancy.

If the applicant lists *all* the goods/services identified in the Notice of Allowance in the section of a pre-printed statement of use form designated for the identification of goods that are not in use (the effect of which is a representation that the mark was not used in connection with any goods), then the applicant has not expressed a clear intention to delete these goods/services, and the examining attorney must inquire as to the discrepancy.

The examining attorney will permit the applicant to amend the statement of use to reinsert any omitted goods/services, if the applicant did not expressly delete the goods/services, and the applicant verifies that the mark was in use in commerce on or in connection with those goods/services before the expiration of the time for filing the statement of use. 37 C.F.R. §2.88(i)(2). Inadvertently omitted goods/services cannot be reinserted by examiner’s amendment, because verification is required.

If the applicant wishes to delete goods/services, the applicant should clearly indicate its intention to delete the omitted goods/services to avoid an unnecessary inquiry by the examining attorney.

Trademark Rule 2.71(a), 37 C.F.R. §2.71(a), prohibits additions to the identification of goods/services. If the applicant proposes to expand the identification of goods/services, the examining attorney must refuse to accept the amendment.

The applicant may amend to limit or clarify the identification of goods/services if the amendment does not exceed the scope of goods/services specified in the notice of allowance. 37 C.F.R. §2.71(a). For example, the applicant may amend to limit the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

goods as to types, channels of trade or class of purchasers, or to restrict an existing item in scope by the introduction of some qualifying language or the substitution of specific for more general terms. The same principles that govern amendments to delete, limit or clarify in general also apply in the examination of the statement of use. *See* TMEP §§1402.06 *et seq.*

### **1109.14 Classification**

If the publication for opposition incorrectly identified the class of the goods/services, the examining attorney should require correction of the classification. Republication is required. Republication is also required when an amendment to the identification of goods after issuance of the notice of allowance results in a change of classification.

If classes are added to the application after the filing of the statement of use, the examining attorney must require payment of the fee(s) for filing the statement of use for the added classes.

### **1109.15 Filing Fees**

Payment of the filing fee for the statement of use is a statutory requirement that must be satisfied before the expiration of the statutory filing period. *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r Pats. 1992).

In a multi-class application, if the applicant files the fee for at least one class of goods or services but fails to file the fees for additional classes, the examining attorney must require payment of the additional fees during examination of the statement of use. The additional fees may be paid after the time for filing the statement of use has expired, within the six-month period for response to the examining attorney's Office action.

If an applicant files a statement of use and a request to divide the application at the same time, and the fees submitted are sufficient for one but not both, the fees will be applied first to the statement of use, and the applicant will be notified of the deficiency. *See* TMEP §§1110.02 and 1110.04 for further information about filing fees for requests to divide.

If the applicant files a final ("insurance") extension request in conjunction with a statement of use (*see* TMEP §1108.03), and the applicant submits fees sufficient for one but not both, the Office will apply the fees as follows: (1) if there is enough money to cover the extension request, the Office will apply the fees to the extension request to avoid abandonment of the application; or (2) if there is enough money to cover the statement of use, but not enough to cover the extension request, the Office will apply the fees to the statement of use.

*See* TMEP §1109.15(a) regarding returned checks, credit card charges that are refused by financial institutions, and fees charged to deposit accounts with insufficient funds.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### 1109.15(a) Processing Deficient Fees

If the filing fee for at least a single class is deficient (*e.g.*, if the fee is charged to a deposit account with insufficient funds, if an authorization to charge the fee to a credit card is refused or charged back by a financial institution, or if the check submitted as payment of the filing fee is returned unpaid), the fee for at least one class of goods or services must be repaid before the expiration of the statutory filing period. If the fee for at least a single class of goods or services is not resubmitted before expiration of the statutory deadline, the application is abandoned.

If a check is returned unpaid or a credit card charge is refused, and the statement of use was accompanied by an authorization to charge deficient fees to a deposit account that has sufficient funds to cover the fee (37 C.F.R. §1.25), the Office will charge the filing fee for the statement of use and the fee for processing the returned check or refused charge (37 C.F.R. §1.21(m)) to the deposit account.

If the examining attorney determines, *before* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney should return the file to the ITU Unit (or the legal instruments examiner in an e-commerce law office) for appropriate action.

If the examining attorney determines, *after* taking an action regarding the statement of use, that the filing fee for at least a single class of goods or services has not been paid, the examining attorney must refuse registration on the ground that the filing fee for the statement of use was not paid. If there is time remaining in the statutory period for filing the statement of use, the examining attorney should require the applicant to resubmit the filing fee on or before the statutory deadline. If a check was returned unpaid or a credit card charge was refused, the examining attorney should also require submission of the processing fee required by 37 C.F.R. §1.21(m); the processing fee may be paid after expiration of the statutory deadline for filing the statement of use.

If the fee for at least a single class has not been paid, and there is no time remaining in the statutory period for filing the statement of use, the examining attorney will issue an Office action refusing registration and stating that the application is abandoned because a proper statement of use was not filed within the time required by statute. 37 C.F.R. §§2.88(e)(1) and 2.88(h). In such a case, the examining attorney should issue a regular Office action, with a six-month response clause. If the applicant does not establish within the six-month response period that the fee for at least a single class of goods or services was paid prior to the expiration of the statutory filing period, the application will be abandoned.

If the fee for at least a single class is paid before expiration of the statutory deadline, but the fee for additional class(es) is deficient, the examining attorney will issue an Office action requiring payment of the fee. The fee may be submitted after expiration of the deadline for filing the statement of use, within the period for response to the examining attorney's Office action. If a check was returned unpaid or a credit card

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

charge was refused, the examining attorney should also require submission of the processing fee required by 37 C.F.R. §1.21(m).

If the statement of use has been approved and the mark is registered when the Office learns that the fee for the statement of use was deficient, the Office will cancel the registration as inadvertently issued. If the fee for at least a single class of goods or services was not paid before the expiration of the statutory filing period, the application will be abandoned. If the fee for at least a single class of goods or services was timely paid, but the fees for additional class(es) have not been paid, the Office will restore the application to pendency and refer it to the examining attorney for appropriate action.

See TMEP §405.01(a) regarding credit card charges that are refused or charged back, TMEP §405.02(a) regarding returned checks, and TMEP §405.03 regarding deposit accounts.

### **1109.16 Correcting Defects in Statement of Use**

The applicant must comply with the statutory requirements for filing the statement of use (37 C.F.R. §2.88(b)) before the expiration of the deadline for filing the statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Other defects may be cured after the expiration of the statutory filing period, within the response periods established under standard examination procedure to avoid abandonment of the application. See TMEP §1109.16(a) regarding defects that must be cured before the expiration of the statutory filing period.

#### **1109.16(a) Statutory Requirements That Must Be Met Within Statutory Filing Period**

The applicant must comply with the statutory requirements for filing a statement of use (37 C.F.R. §2.88(b)) before expiration of the period for filing the statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use). Thus, the following deficiencies must be cured before expiration of the statutory filing period:

- (1) *Specimens and Dates of Use in Commerce.* The applicant must make valid use of the mark in commerce and must, for each class, provide one specimen that was in use before the expiration of the time permitted for filing the statement of use. 37 C.F.R. §2.59(b)(2). If the applicant does not provide an acceptable specimen that was in use in commerce before the expiration of the deadline for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. See TMEP §1109.09(b).

The examining attorney must refuse registration on the same grounds if the applicant attempts to amend the dates of use to state a date of first use in

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

commerce that is later than the time permitted for filing the statement of use. 37 C.F.R. §2.71(c)(2); TMEP §1109.09(a).

- (2) *Filing by Owner.* The party filing the statement of use must be the owner of the mark at the time of filing. If the party who filed the statement of use was not the owner at the time of filing the statement of use, the applicant may not provide a substitute statement of use (or the equivalent) in the name of the true owner after the expiration of the deadline for filing the statement of use. *In re Colombo, Inc.* 33 USPQ2d 1530 (Comm'r Pats. 1994). Therefore, if the party filing the statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the examining attorney must refuse registration and hold the application abandoned because the owner failed to file a statement of use within the time permitted. TMEP §1109.10.
- (3) *Verification.* The statement of use must be verified by someone properly authorized to sign on behalf of applicant. If the statement of use is unsigned or signed by the wrong party, a substitute verification must be filed before the expiration of the statutory period for filing the statement of use. 37 C.F.R. §2.88(e)(3). Generally, however, the Office does not question the authority of the person who verifies a statement of use. See TMEP §1109.11(a).
- (4) *Filing Fee For At Least a Single Class.* Payment of the filing fee for at least a single class is a statutory requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. See TMEP §§1109.15 and 1109.15(a).

When refusing registration on the above grounds, the examining attorney should issue a regular Office action with a six-month response clause. See TMEP §1109.16(b).

### **1109.16(b) Issuance of Examining Attorney's Office Action Holding that a Statement of Use Does Not Meet the Minimum Filing Requirements**

When the examining attorney determines that the applicant did not meet the minimum statutory requirements within the period for filing the statement of use, the examining attorney must issue an Office action refusing registration on the ground that the applicant did not file a statement of use that meets the requirements of 15 U.S.C. §1051(d)(1). If there is time remaining in the statutory filing period, the Office action should state that the deficiency must be cured before the expiration of the deadline for filing the statement of use.

If there is no time remaining in the statutory filing period, the examining attorney should issue an Office action with a six-month response clause, stating that the application will be abandoned for failure to timely file a statement of use that meets the requirements of §1(d)(1) of the Act. Even if the statutory filing period has expired, the Office action should include a six-month response clause. This gives the

applicant six months to establish that it met the minimum requirements on or before the expiration of the time for filing the statement of use.

If the applicant fails to respond to the Office action, the application will be abandoned for failure to respond. If the applicant responds to the Office action, but does not establish that the requirements for filing a statement of use had been satisfied *as of the expiration of the deadline for filing the statement of use*, the examining attorney will make the refusal of registration final. If the applicant does not respond, the application will be abandoned for failure to respond to the final refusal.

*See* TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that the applicant did not comply with the statutory requirements for filing the statement of use within the statutory filing period.

**1109.16(c) Requesting an Extension of Time to File a Statement of Use for the Purpose of Compliance with Minimum Filing Requirements**

In limited circumstances, an applicant may file a request for an extension of time to file a statement of use after filing a statement of use, in order to gain more time to comply with the minimum requirements for filing the statement of use (an "insurance" extension request). An applicant may file an extension request after filing a statement of use only if: (1) there is time remaining in the statutory period for filing the statement of use; (2) no extension request was filed together with the statement of use; *and* (3) granting the extension would not extend the time for filing the statement of use more than thirty-six months beyond the issuance of the notice of allowance. 37 C.F.R. §2.89(e)(1). *See* TMEP §1108.03 regarding the time periods and requirements for filing an "insurance" extension request, and TMEP §1108.03(a) regarding the procedures for processing such a request.

The filing of such an extension request is not in itself a proper response to an Office action, and does not extend the six-month period for response to the Office action. *See* TMEP §1109.16(d).

*Example:* Assume that a notice of allowance issues July 3, 2002; the applicant files a statement of use on July 22, 2002; and the examining attorney issues an Office action requiring substitute specimens on August 6, 2002. The applicant may file its first extension request on or before January 3, 2003, which would give the applicant until July 3, 2003 to make proper use of the mark. However, the applicant must file a response to the Office action on or before February 6, 2003. *See* TMEP §1109.16(d) for information about responding to an Office action in this situation.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### **1109.16(d) Response to Office Action Required Within Six Months of Mailing Date Regardless of Expiration Date of Period for Filing the Statement of Use**

In limited circumstances, when the applicant files an extension request in conjunction with or after filing a statement of use (*see* TMEP §1108.03 regarding “insurance” extension requests), the six-month period for response to the examining attorney’s Office action will expire before the statutory deadline for filing the statement of use. To avoid abandonment, the applicant must respond to the Office action within six months of the mailing date, regardless of the expiration date of the time for filing the statement of use.

If the time for filing the statement of use expires after the time for responding to an Office action, and the applicant believes that it can cure a deficiency raised in the Office action before expiration of the time for filing the statement of use, the applicant should timely respond to the Office action, stating in the response that it intends to comply with the minimum requirements for filing the statement of use on or before the expiration of the statutory filing period.

If the applicant files such a response, the examining attorney should *not* suspend the application. Instead, the examining attorney should make final any outstanding refusal or requirement. The applicant will then have six months from the mailing date of the final action to cure statutory deficiencies. Of course, applicant must comply with the minimum requirements for filing the statement of use before the expiration date of the deadline for filing the statement of use.

*Example:* If the deadline for filing the statement of use expires July 3, 2002, and the examining attorney issues an Office action requiring substitute specimens on March 4, 2002, the applicant has until September 4, 2002, to file the substitute specimens, but the applicant must verify that the specimens were in use in commerce on or before July 3, 2002.

If the applicant files a proper response to the final Office action within six months of the mailing date, *and* complies with the minimum requirements for filing the statement of use before the expiration of the period for filing the statement of use, the examining attorney will withdraw the refusal based on non-compliance with the statutory requirements for filing the statement of use.

### **1109.16(e) Applicant’s Recourse After Refusal of Registration**

If the applicant unintentionally fails to meet the minimum requirements for *filing* a statement of use, as set forth in 37 C.F.R. §2.88(e) (*see* TMEP §1109.01), the applicant may file a petition to revive under 37 C.F.R. §2.66. However, if the applicant met the minimum filing requirements of 37 C.F.R. §2.88(e), but the examining attorney later refuses registration on the ground that the applicant failed to satisfy the statutory requirements for a *complete* statement of use on or before the statutory deadline (*e.g.*, because the specimen is unacceptable or the dates of use are

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

subsequent to the deadline for filing the statement of use), the applicant cannot overcome the refusal by filing a petition to revive under 37 C.F.R. §2.66. TMEP §1714.01(f)(ii). The applicant's only recourse is to appeal the examining attorney's refusal of registration to the Trademark Trial and Appeal Board.

*See* 37 C.F.R. §2.88(b) and TMEP §1109.16(a) regarding the statutory requirements that must be met within the statutory period for filing the statement of use (*i.e.*, within six months of the mailing date of the notice of allowance or before the expiration of an extension of time for filing a statement of use).

### **1109.17                      Withdrawal of the Statement of Use Prohibited**

Once an applicant has filed a statement of use, the applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g). *In re Informix Software, Inc.*, 32 USPQ2d 1861 (Comm'r Pats. 1993). The statement of use may not be withdrawn even if the Office determines that the statement of use does not comply with the minimum filing requirements.

*See* TMEP §1109.16(e) regarding the applicant's recourse after an examining attorney's refusal of registration on the ground that applicant did not meet the statutory requirements for filing a statement of use before the expiration of the statutory deadline.

### **1109.18                      Approval of the Statement of Use**

Approval of the statement of use indicates that the mark is eligible for registration. If the examining attorney determines that the application is in condition for registration, the examining attorney will sign the block on the file wrapper marked "Approved for Registration (Section 1(d))" to indicate approval of the statement of use. Before signing the file to indicate approval, the examining attorney must ensure that the information contained in the file is accurate, that material that should be printed in the *Official Gazette* and on the registration certificate is bracketed and marked "PRINT," and that relevant material is marked "DO NOT PRINT." *See* TMEP §817. If an assignment has been recorded, the examining attorney should instruct the legal instruments examiner to update the ownership information in TRAM. *See* TMEP §502.01. The examining attorney must also perform the appropriate TRAM transaction to ensure that the computer-generated notice of approval of the statement of use is issued.

If the applicant filed an amendment to the Supplemental Register with or after filing a statement of use, and the application is otherwise in condition to be approved for registration, the examining attorney should approve the statement of use and approve the application for registration on the Supplemental Register. *See* TMEP §1102.03 regarding the examination of intent-to-use applications for registration on the Supplemental Register.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### 1110 Request to Divide an Application

37 C.F.R. §2.87. *Dividing an application.*

(a) *An application may be physically divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.*

(b) *In the case of a request to divide out one or more entire classes from an application, only the fee under paragraph (a) of this section will be required. However, in the case of a request to divide out some, but not all, of the goods or services in a class, an application filing fee for each new separate application to be created by the division must be submitted, together with the fee under paragraph (a) of this section. Any outstanding time period for action by the applicant in the original application at the time of the division will be applicable to each new separate application created by the division.*

(c) *A request to divide an application may be filed at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board. Additionally, a request to divide an application under section 1(b) of the Act may be filed with a statement of use under §2.88 or at any time between the filing of a statement of use and the date the Trademark Examining Attorney approves the mark for registration.*

(d) *A request to divide an application should be made in a separate paper from any other amendment or response in the application. The title "Request to divide application." should appear at the top of the first page of the paper.*

Under 37 C.F.R. §2.87(a), an applicant may divide the application into two or more separate applications upon payment of the applicable fees. When dividing an application, the applicant preserves the filing date for all the goods/services covered by the application. See 37 C.F.R. §2.87(b) and TMEP §1110.02 regarding the fees for a request to divide.

An applicant may request division of an application for any reason. For example, in an intent-to-use application, the applicant may wish to proceed to publication or registration with the goods/services on or in connection with which the applicant has used the mark in commerce and retain an active intent-to-use application for any remaining goods/services.

The applicant *must* file a request to divide if the applicant files an amendment to allege use before making use on all the goods/services for which applicant seeks registration under §1(b), or a statement of use before making use on all the goods/services specified in the notice of allowance. 37 C.F.R. §§2.76(c) and 2.88(c); TMEP §§1104.03(a) and 1109.03.

**1110.01 Time for Filing Request to Divide**

An applicant may file a request to divide the application at any time between the filing of the application and the date the examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding upon motion granted by the Trademark Trial and Appeal Board. A request to divide a §1(b) application may also be filed with a statement of use or at any time between the filing of a statement of use and the date the examining attorney approves the mark for registration. 37 C.F.R. §2.87(c). If the Office receives a request to divide at any other time, the Office will return the request to the applicant with any fee(s) submitted, and the application will not be divided.

**1110.02 Fee for Filing Request to Divide**

A request to divide out one or more entire classes from an application must be accompanied by a fee for dividing the application. This fee is based on the number of new applications created by the division. 37 C.F.R. §§2.6(a)(19), 2.87(a), and 2.87(b).

A request to divide out some, but not all, of the goods or services in a class must be accompanied by the fee for dividing the application, based on the number of new applications created, *and* by an application filing fee for each new separate application created by the division. 37 C.F.R. §§2.6(a)(1), 2.6(a)(19), 2.87(a) and 2.87(b).

If the request to divide does not include the required fee(s), the ITU/Divisional Unit will notify the applicant of the deficiency and grant the applicant time to submit the required fees. The applicant must submit the fee within the time permitted, or the request to divide will be considered abandoned and the application will not be divided. If the applicant does not submit the necessary fees, the ITU/Divisional Unit will notify the applicant that the request to divide is considered abandoned.

*See* TMEP §1110.04 regarding the application of fees when an applicant files a request to divide in conjunction with a statement of use and/or request for an extension of time to file a statement of use, but submits insufficient fees.

**1110.03 Processing Request to Divide**

All requests to divide should be immediately forwarded to the ITU/Divisional Unit of the Office for processing, unless the application is the subject of a proceeding before the Trademark Trial and Appeal Board. *See* TMEP §1110.06 regarding requests to divide applications that are the subject of a proceeding at the Board.

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

### 1110.04 Dividing an Application When Statement of Use is Due

Filing a request to divide does not extend the deadline for filing a statement of use or request for extension of time to file a statement of use in response to a Notice of Allowance.

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(b). Therefore, if a statement of use is due, the statement of use (or request for extension of time to file a statement of use) is due in each new application created by the division unless the following exception applies: In a multi-basis application, if the applicant files a request to divide out the basis or bases to which the Notice of Allowance does not pertain before the deadline for filing the statement of use, the new applications created by the division are not affected by the Notice of Allowance.

A request to divide *must* be filed if the applicant files a statement of use before making use of the mark in commerce on all the goods/services specified in the notice of allowance, unless the applicant deleted the goods/services that are not in use. 37 C.F.R. §2.88(c); TMEP §1109.03.

Requests to divide are given priority in processing over any other paper, with one exception: If the applicant submits a request for an extension of time to file a statement of use at the same time as or before the request to divide, *and* the extension request applies to the resulting applications, the extension request will be processed first. This provides the applicant with an extension that applies to all resulting applications without requiring additional fees for extension requests.

When the applicant files a request to divide goods that are in use from goods that are not yet in use, the Office puts the goods in use in the newly created (child) application, and retains the goods not in use in the original (parent) application. The reason for this procedure is that more child applications may be created from the parent file, and the ITU/Divisional Unit can then make copies from the original papers.

If the applicant submits a request to divide along with a statement of use and a request for an extension of time to file a statement of use, and the fees are insufficient to cover all three, the fees will be applied first to the extension request (if there is enough to cover the extension request), second to the statement of use, and last to the request to divide. *See* TMEP §§1108.02(c) regarding fee deficiencies in extension requests, TMEP §§1109.15 and 1109.15(a) regarding fee deficiencies in statements of use, and TMEP §1110.02 regarding fee deficiencies in requests to divide.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1110.05 Dividing an Application When Response to Office Action is Due**

Filing a request to divide is not a proper response to an Office action and does not relieve an applicant of the duty to respond to any outstanding Office action or to take any other required action.

Any outstanding deadline in effect at the time the application is divided applies not only to the original application, but also to each new application created by the division of the application. 37 C.F.R. §2.87(b). Therefore, if a response to an Office action is due, the response is due in each new application created by the division of the application, unless one of the following exceptions applies:

- (1) If the Office action pertains to less than all the classes in a multi-class application, and the applicant files a request to divide out the class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.
- (2) If the Office action pertains to only one basis in a multi-basis application, and the applicant files a request to divide out the basis to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application.

If the applicant files a request to divide goods or services that are subject to a refusal from goods or services that are not subject to a refusal, the Office puts the goods/services that are *not* subject to refusal in the child application, and retains the goods/services that *are* subject to refusal in the parent application. The reason for this procedure is that more child applications may be created from the parent file, and the ITU/Divisional Unit can then make copies from the original papers.

When a request to divide is filed together with a response to an Office action, the legal instruments examiner should first enter the response, and then forward the request to divide and the application file to the ITU/Divisional Unit. The ITU/Divisional Unit will process the request and then return the application to regular processing.

A request to divide may be made by examiner's amendment in appropriate circumstances. The fee must be paid by credit card or deposit account authorization.

### **1110.06 Dividing an Application Subject to a Proceeding at Trademark Trial and Appeal Board**

A request to divide may be filed during an opposition, concurrent use, or interference proceeding upon motion granted by the Trademark Trial and Appeal Board. 37 C.F.R. §2.87(c). When an application is the subject of a proceeding before the Board, any request to divide should first be sent to the Board for appropriate action. If the

## INTENT TO USE APPLICATIONS AND RELATED DOCUMENTS

Board determines that the request to divide should be granted, the Board will forward the request and the application file to the ITU Unit with instructions for dividing the application. The ITU Unit will process the request and then return the application to regular processing. *See* TBMP §516.

### **1110.07                    Dividing a §44 Application [R-2]**

When the applicant divides an application that includes a claim of priority under §44(d), the new application(s) created through the division retain the priority filing date, provided that each application meets the requirements of §44(d). This is true even if the applicant does not ultimately perfect a §44(e) basis (*see* TMEP §§806.01(c) and 806.02(f)).

When an applicant requests division of an application that includes a copy of a foreign registration, the applicant does not have to provide additional copies for each application created by the division.

### **1110.08                    Division of Registration Not Permitted**

A registration cannot be divided.